

REVIEW OF LEGISLATION

URUGUAY¹

This document reproduces the introductory statement made by the delegation of Uruguay, the questions addressed to it and the responses given in connection with the review of legislation undertaken at the Council meeting held from 27 to 28 November 2001.²

I. INTRODUCTORY STATEMENT

A. INTRODUCTION

Uruguay has signed two particularly significant international agreements:

- The Paris Convention for the Protection of Industrial Property (Stockholm Act of 1967), approved by Decree-Law No. 14.910 of 10 July 1979, and
- the Marrakesh Agreement Establishing the World Trade Organization and the annexes thereto containing the multilateral trade agreements concluded during the Uruguay Round of Multilateral Trade Negotiations. These include the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), approved by Law No. 16.671 of 13 December 1994.

Both agreements have consequently been incorporated into domestic legislation and their provisions are in force.

Uruguay has availed itself of the transitional period provided for in Articles 65.1, 65.2 and 65.4 of the TRIPS Agreement, given that it fulfils the requirements set forth therein.

Nevertheless, the changes in its laws made during this period have taken the provisions of Article 65.5 of the TRIPS Agreement into consideration.

¹ For the laws and regulations relevant to the subject under review and notified by Uruguay under Article 63.2 of the Agreement, see documents IP/N/URY/1; IP/N/1/URY/2 and Add.1; IP/N/1/URY/3; IP/N/1/URY/C/1 to 6; IP/N/1/URY/I/1 to 4; IP/N/1/URY/O/1; IP/N/1/URY/P/1 to 3; IP/N/1/URY/U/1.

² The minutes of the meeting were circulated in document IP/C/M/34.

The following laws were issued on that basis:

- Trademark Law No. 17.011 of 25 September 1998, and
- Patent Law No. 17.164 of 20 September 1999.

The competent authority in matters relating to industrial property is the National Directorate of Industrial Property, which is responsible for the conduct, planning and implementation of national policy in this area.

Its role is to manage and protect industrial property rights concerning trademarks, patents, utility models and industrial designs in line with technological and commercial developments at national and international level.

As of 1999, the National Directorate of Industrial Property has introduced and uses an ISO 9000 quality system certified by the Austrian Association for the Certification of Quality Control Systems (ÖQS).

An intellectual property system must encompass not only regulatory aspects, but also administrative and judicial aspects, which are the ones that ensure the effective enforcement of regulations.

In this respect, intellectual property laws alone do not suffice; transparent, flexible and reliable protection and enforcement mechanisms which guarantee system users protection of their rights are also required.

Uruguay has the necessary instruments to enforce such rights.

B. TRADEMARKS

Law No. 17.011, although entitled "Trademark Law" (a trademark being the distinctive sign *par excellence*), also regulates trade names, appellations of origin and indications of source.

Article 1 states that the term "trademark" means any sign capable of distinguishing the goods or services of one natural or legal person from those of other natural or legal persons.

Article 2 provides for the registration of non-visible signs - an innovation which brings Uruguayan legislation into line with the more modern legislation of industrialized countries.

The Law makes express provision for the registration of original advertising slogans, thereby embracing the new trade trends linking trademarks to the advertising of goods or services.

It expressly prohibits the registration as a trademark of appellations of origin and indications of source, although geographical names which are original and distinctive and not confusing or misleading with regard to the origin, source, qualities or characteristics of the goods to which they apply may be used as trademarks.

Uruguayan legislation follows the constitutive system whereby ownership of, and the exclusive right to use, a given trademark comes into effect with registration. Nevertheless, provision has been made for a transition period of two years from the entry into force of the Law, during which the owners of trademarks which are in use but not registered may challenge a registration.

Express provision is made for the possibility of licence registration, seizures and prohibitions on innovation. Furthermore, the Trademark Office is vested with recordal competence as regards non-possessory trademark pledges, thereby bringing the entire trademark spectrum under the responsibility of a single government agency in order to afford greater security and certainty to users.

This Law governs certification or guarantee marks and collective marks, which were conceived subsequent to the previous version and therefore not provided for therein.

The Trademark Law and its Regulatory Decree lay down a set of specific administrative procedures for trademark registration and renewal.

Furthermore, with regard to enforcement in cases of infringements of the trademark regulations, administrative and judicial (both criminal and civil) proceedings are provided for by legislation and governed as applicable by Decree No. 500/91, the General Code of Procedure and the Code of Criminal Procedure.

C. PATENTS

Law No. 17.164, approved on 2 September 1999 and in force as from 18 January 2000, brings together in a single text the rights and obligations relating to patents, utility models and industrial designs.

This Law establishes that inventions of products or processes which are new, involve an inventive step and are capable of industrial application are patentable; i.e. this basic provision includes all fields of technology without discrimination as to the place of invention, technological sector or origin of the patented products or processes.

Pursuant to the TRIPS Agreement, patent protection is extended to pharmaceutical and agricultural chemical products as from 1 November 2001, i.e. Uruguay has availed itself of a shorter period than that provided for in Article 65.4 of the TRIPS Agreement.

In accordance with the TRIPS Agreement, the Law provides that plants and animals, other than micro-organisms, and essentially biological processes for the production of plants or animals, other than non-biological and microbiological processes, are not considered inventions. It also establishes that neither are biological and genetic material as found in nature considered to be inventions.

The Law establishes a period of validity for patents of twenty (20) years from the filing date of the application.

The rights conferred by the patent on its holder and the limited exceptions thereto are expressly defined.

Importation is established as a means of patent exploitation.

Patent applications are published eighteen (18) months from the filing date of the application or the priority date claimed.

The application indicates the time-limit during which the application remains confidential. Informed comment on the patentability of the invention may be made thereafter by any interested party.

Other guarantees for interested parties are the system of administrative remedies and the possibility of requesting administrative invalidation on the grounds of failure to meet the conditions of patentability.

The Law provides for the international exhaustion of rights, i.e. once a patented product has been lawfully put on the market in Uruguay or abroad, the rights conferred on the patent holder in respect of that product are exhausted.

Compulsory licences or other uses are granted without the authorization of the patent owner for various reasons in order to prevent the improper exercise of rights by the patent holder and thereby avoid distortion and injury.

Their scope and term shall be adapted to the purpose for which they were granted.

In accordance with Article 34 of the TRIPS Agreement, it is provided that, for the purposes of civil proceedings in respect of the infringement of patent rights, if the subject-matter of the patent is a process for obtaining a product, the judicial authorities have the authority to order the defendant to prove that the process to obtain the product is different from the patented process, if the product obtained by the patented process is new.

With regard to enforcement, the civil and criminal proceedings which can be undertaken by the owner of the infringed patent are set out in a specific chapter. Moreover, under the General Code of Procedures, the judicial authority is empowered to adopt, *ex officio* or at the request of a party, provisional or precautionary measures.

D. UTILITY MODELS

These are characterized by less stringent novelty and inventiveness requirements.

The term of protection is ten (10) years from the filing date of the application, with the possibility of an extension for a further five (5) years.

E. INDUSTRIAL DESIGNS

Express provision is made for the possibility of combining the protection of an industrial design with that of other industrial property systems.

The rights conferred by the industrial design on its author and the limited exceptions thereto are expressly defined.

The term of protection is ten (10) years from the filing date of the application, with the possibility of an extension for a further five (5) years.

It is stipulated that the provisions relating to patents also govern industrial designs, insofar as they are applicable.

F. LAYOUT-DESIGNS (TOPOGRAPHIES) OF INTEGRATED CIRCUITS

Uruguay's ratification of the TRIPS Agreement incorporated its provisions on integrated circuits into domestic legislation.

Layout-designs that meet the corresponding requirements for the acquisition of each type of right may therefore acquire protection through patents, industrial designs or copyright, or even through the rules on unfair competition.

G. PROTECTION OF UNDISCLOSED INFORMATION

Given that the provisions of the Paris Convention and the TRIPS Agreement have been incorporated into Uruguayan legislation and that, to date, Uruguay has no specific legislative provisions on undisclosed information, such information is protected by the rules on unlawful competition.

Copyright and related rights

Of particular note in Uruguay with regard to such rights are not merely the developments to the Law of 1937, basically with regard to the treatment of infringements and the respective civil and criminal penalties, but also the country's prevailing tendency to ratify the various international conventions concluded in this field.

We first of all wish to highlight the explicit recognition accorded to copyright and related rights in our National Constitution, Articles 7, 33, 34, 53, 72 and 332 of which afford broad protection to such rights.

In particular, Article 33, the text of which has remained the same since the 1934 Constitution, stipulates that "Intellectual works and the copyright of authors, inventors or artists shall be recognized and protected by law".

The Copyright Law currently in force in Uruguay is Law No. 9.739 of 17 December 1937. Article 19 of its Regulatory Decree of 21 April 1938 has been amended pursuant to Decree No. 281/1989.

Aspects of this law worthy of special mention include the following: the protection of authors' moral and economic rights; authors' exclusive right to exploit their works; the national treatment principle (Article 4); an illustrative list of protected works; establishment of the *droit de suite*; and a chapter on civil and criminal wrongs.

Article 46 of Law No. 9.739 (on criminal penalties) was amended by Article 23 of Law 15.913, as indicated further on in this document.

The most recent amendment was introduced by Law No. 16.170 of 27 December 1990, Article 328 of which replaced Articles 47 and 57 of Law No. 9.739, as described further on.

The Berne Convention for the Protection of Literary and Artistic Works (Paris Act of 24 July 1971) was approved by Decree-Law No. 14.910 of 19 July 1979.

The Rome Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations was approved by Decree-Law No. 14.587 of 19 October 1976.

The Convention for the Protection of Producers of Phonograms Against Unauthorized Duplication of Their Phonograms was approved by means of Decree-Law No. 15.012 of 13 May 1980.

Decree-Law No. 15.289 of 14 July 1982 introduced a new criminal offence with a view to protecting producers of phonograms and/or videograms from unauthorized reproductions. The text also provides for the protection of authors and artists.

Article 1 thereof provides that "Anyone reproducing a phonogram or videogram for gain and without the written authorization of its producer, and anyone distributing to the public or stocking for that purpose the reproductions thus obtained, shall be liable to the penalty laid down in Article 46 of Law No. 9.739 of 17 December 1937. The same penalty shall be applicable to anyone fixing the live performance of a literary or artistic work by any means, clearly for the purpose indicated in the previous sentence and without the written authorization of the author and the performer, as well as to anyone distributing to the public or stocking for that purpose the versions thus obtained".

As previously mentioned, Article 23 of Law No. 15.913 of 17 November 1987 amended Article 46 of the Copyright Law of 1937.

The text thereof is as follows: "Whoever publishes, sells, reproduces or causes to be reproduced by any means, in whole or in part, an unpublished or published work without the written authorization of its author or his successor in title or its purchaser, in whatever capacity, or attributes it to a different author, thereby contravening the provisions of this Law, shall be liable to a term of from three months' to three years' imprisonment."

The first statutory recognition of computer programs under the copyright law came with Decree No. 154/989 of 11 April 1989. This Decree amends the article of the Regulatory Decree which establishes the procedure for registering such programs.

On 6 February 1991, the Executive Branch issued a Decree whereby the State incorporates software into its computer network.

Article 328 of Law No. 16.170 of 27 December 1990 subsequently replaced Articles 47 and 57 of Law No. 9.739 of 17 December 1937.

The texts currently in force are as follows:

Article 47: "The unlawfully reproduced copies and any materials used for reproduction, communication or public performance shall be seized.

As a preparatory measure, the interested party may request their attachment and, where good cause can be shown, apply to the competent court for exemption from counter-security.

The judgement shall, in all cases, order the destruction or disablement of the copies and materials seized, if these are able to be used, to the extent necessary to prevent unlawful exploitation.

Copies acquired by third parties in good faith for their personal use shall not be destroyed".

Article 57 provides that the Copyright Board shall be composed of five members appointed by the Ministry of Education and Culture.

Law No. 16.321 of 27 October 1992 approved the Universal Copyright Convention, as revised at Paris on 24 July 1971.

Decree No. 353/993 of 3 August 1993 established that television companies enjoy the exclusive right to authorize the retransmission and fixation of their broadcasts and reproductions thereof.

Law No. 16.671, published in the Official Journal of 29 December 1994, approved the signed agreements resulting from the Uruguay Round of Multilateral Trade Negotiations, as contained in the Final Act signed at Marrakesh.

Furthermore, Uruguay has a long history as a signatory to pan-American conventions on copyright and related rights, as follows:

Treaty on Literary and Artistic Property of 1889; Convention on copyright of 1910 (Buenos Aires); Havana Convention of 1928; Buenos Aires Convention on the Protection of Literary and Artistic Property, as revised by the sixth International Conference of American States; Treaty on Intellectual Property of 1939 (Montevideo) with Argentina, Bolivia, Paraguay, Peru and Uruguay; Washington Convention of 1946; Inter-American Convention on the Rights of the Author in Literary, Scientific and Artistic Works.

The 1996 WIPO treaties on copyright and related rights are currently being considered by the Senate of the Republic. These treaties were adopted by the WIPO Diplomatic Conference on Certain Copyright and Neighbouring Rights Questions in Geneva on 20 December 1996.

Finally, Mr. Chairman, Uruguay was addressed a large number of questions by Canada, Switzerland, the United States, the European Communities and their Member States and Japan and, in spite of the fact that they were received outside the established time-limits, considerable efforts were made to provide written responses. These have been circulated to all Members and forwarded to the Secretariat for translation.

We are open to further questions on our legislation and presentation and these will receive a written reply promptly and within the relevant time-frames.

II. REPLIES TO THE QUESTIONS POSED BY CANADA

1. Please describe how the enforcement obligations (Articles 41-61 of the TRIPS Agreement) have been implemented.

Article 41 - Expeditious deterrent action, both administrative and judicial, can be taken against any act of infringement:

From the administrative standpoint, both Trademark Law No. 17.011 and its Regulatory Decree No. 34/99 and Patent Law No. 17.164 and its Regulatory Decree No. 11/00 provide for special administrative procedures based on the latest standards.

From the judicial standpoint, both Law No. 17.011 and Law No. 17.164 establish, in Articles 81 to 85 and 106 to 107, respectively, offences and penalties for infringers of industrial property rights: trademarks and appellations of origin, in the first case, and patents, utility models and industrial designs, in the second.

Likewise, Articles 87 and 88 of Law No. 17.011 and Articles 99 to 105 of Law No. 17.164 provide for civil proceedings for infringements of the trademark and patent regulations.

All these proceedings, both administrative and judicial, whether criminal or civil, are based on the constitutional principle of due process. The administrative procedure is laid down in special laws and decrees, as well as in General Decree No. 500/91 which applies to the Uruguayan public service in general. Civil proceedings are governed by the General Code of Procedure (GCP) and criminal proceedings by the Code of Criminal Procedure (CCP).

Administrative decisions are taken by the competent administrative authority through administrative acts, which are always reasoned and in writing, within a file that always takes written form. Judicial decisions (judgments), also in writing and duly reasoned, are taken by the judges who make up the judiciary. These decisions must be notified to the parties personally or, if this is physically impossible, by means which ensure that the interested party is aware of them.

As far as evidence is concerned, all the parties involved have an opportunity to produce evidence, to verify the evidence produced by the other party and to submit arguments relating to the evidence produced. The time-limits for producing evidence, the way in which the evidence is presented and the form it takes are all regulated, as are the time-limits for processing it and for submitting arguments.

Administrative decisions can be reviewed by a specialized five-member quasi-judicial body (Administrative Tribunal). Judicial decisions made by judges in the courts of first instance, whether civil (civil or district judges depending on the jurisdiction) or criminal, can always be reviewed by the specialized appeal courts. In these cases, the judgements, depending on the jurisdiction, can be set aside by the five-member Supreme Court of Justice, the highest judicial authority.

Article 42 - The judicial procedures concerning enforcement are laid down in Articles 87 and 88 of Trademark Law No. 17.011, which authorize actions for damages and the prohibition of the use of infringing marks, and Articles 99 to 105 of Patent Law No. 17.164, which authorize actions against anyone performing acts in violation of the rights deriving therefrom. In these cases, the interested parties may make use of the ordinary proceedings laid down in Articles 337 *et seq.* of the GCP or the precautionary proceedings laid down in Articles 311 *et seq.* of the same Code. Those concerned are personally notified of all complaints and receive a copy of the document. Article 44 of the Code permits the parties to be represented by their attorney, except at the preliminary hearing when they must appear in person accompanied by a lawyer. The court costs correspond to the fees and charges laid down by the budgetary laws in force and are relatively low. Each party must attach to the complaint or plea the evidence on which its arguments are based (Articles 117 and 131 GCP) and this evidence is collected by the Court: the documentary evidence is combined with the notification of the other party, the procedural documents are processed and witnesses are questioned (Articles 341 and 343 GCP). The two parties then plead on the basis of the evidence presented (Article 343 GCP) and, finally, the judge delivers a duly reasoned judgement (Article 343 GCP), which may be appealed by either of the parties (Articles 248 to 261), in which case the file is transmitted to a three-member higher court or tribunal (Article 344 GCP). As regards the identification and protection of confidential information, if the party required to submit it can justify its request for confidentiality, the judge in the proceedings may take the measures necessary for its protection. Moreover, the law expressly provides for this in criminal inquiry proceedings under the CCP and in connection with confidential precautionary measures under the GCP, etc.).

Article 43 - Article 168 of the GCP allows the plaintiff to request that the other party be ordered to produce documentation within its control which the plaintiff wishes to use. The same article stipulates that refusal may be regarded as acknowledgement of content.

Article 44 - There is no such legal authority in the field of intellectual property right protection. It is expressly provided for in cases of infringement of the customs regulations, namely: in cases of fraud, discrepancies and smuggling under Article 245 of Law No. 13.318.

Article 45 - Article 87 of Trademark Law No. 17.011 and Articles 99, 100 and 102 of Patent Law No. 17.164 empower the ordinary courts to order infringers of industrial property rights to pay damages where there is fault or fraud. The payment of costs and charges may be ordered only in cases of bad faith or culpable negligence. In general, Articles 1.319, 1.323 and 1.324 provide for liability and damages where there is fault or fraud.

Article 46 - Where an offence has been committed, Article 84 of Trademark Law No. 17.011 provides for the marks and the implements used for making them to be destroyed or rendered unusable and for the infringing goods to be forfeited and destroyed, unless they can be awarded to public or private charitable institutions. Article 106 of Patent Law No. 17.164 provides for the seizure of the infringing goods and the implements used in making them and for their fate to be decided in consultation with the NIPD.

Article 47 - This is within the powers of the investigating judge, always provided that due process is observed.

Article 48 - This possibility always exists insofar as injury consequent upon the abuse of procedures can be proved. The payment of costs may also be ordered where reckless malice can be shown.

Article 49 - Every kind of civil proceedings, whether the result of an administrative act or of an infringement on the part of a private individual, affords the same guarantees of due process and is governed by the General Code of Procedure.

Article 50.1 - Article 103 of Patent Law No. 17.164 provides for the adoption of provisional or precautionary measures in accordance with the GCP. Article 317 of the GCP deals with provisional measures, laying down the same procedure as for precautionary measures (Articles 311 to 316). Where the preservation of evidence is concerned, in addition to these articles, Article 309.6 on preliminary measures also applies.

Article 50.2 - Article 315 of the GCP provides for measures of this kind to be ordered without the knowledge or intervention of the other party.

Article 50.3 - Articles 314.2 and 314.3 of the GCP require the production of *prima facie* evidence and the provision of counter-security, and the adoption of the measure is decided as soon as the evidence has been examined.

Article 50.4 - Article 315 of the GCP provides for notification of the measure immediately upon execution, and both the person affected by the measure and the applicant may appeal the decision.

Article 50.5 - The court may always request further evidence of the right in order to facilitate its decision. This is a general procedural principle enshrined in the GCP.

Article 50.6 - Article 311.2 of the GCP provides for precautionary measures to lapse automatically if a complaint is not lodged within 30 days and for the applicant to be ordered to pay all the costs of the proceedings and any damages.

Article 50.7 - As already mentioned in connection with the previous article, compensation for injury is provided for in Article 311.2 of the GCP.

Article 50.8 - Provisional measures may be ordered under administrative procedures, since Decree No. 500/91 on administrative procedures authorizes the application of the GCP, wherever relevant.

Article 51 - The release of goods may be suspended by the judicial (customs court) or administrative (customs collectors) authorities upon receipt of a substantiated complaint that goods are about to be imported in infringement of intellectual property rights. Once it is shown that the offence is not one of the three for which Law No. 13.318 on customs disputes provides, namely, smuggling, discrepancies and fraud, the customs court must render account to the Criminal Court.

Article 52 - The characteristics of the application are the same whether it is submitted under the judicial or the administrative procedure, and under Article 117 of the GCP it must always be accompanied by evidence of infringement.

Article 53 - The possibility of requiring security is afforded only in cases of a customs offence: discrepancies, smuggling or fraud, in Article 163 of Law No. 17.296 and Decree No. 67/2001.

Article 54 - Notification is always given when Article 51 measures are taken.

Article 55 - If suspension is decided upon by the administrative authority, it has 24 hours to inform the judge and five days to transmit the case file to the customs court (Law No. 13.318). If it is decided upon by the judicial authority, there is no specified period.

Article 56 - The indemnification of the importer or the owner of the goods must be pursued before the civil judicial authorities under the above-mentioned general rules on damages of the Civil Code, in which case injury must always be proved.

Article 57 - Always granted by both the competent administrative (customs) and judicial authorities.

Article 58 - There is no provision for *ex officio* action. Nevertheless, customs administrative proceedings have been initiated through the Foreign Ministry at the request of another Member's Embassy.

Article 59 - Can only be ordered by the criminal court judge once the case enters his jurisdiction.

Article 60 - There is no such provision.

Article 61 - Articles 81 to 83 of Trademark Law No. 17.011 establish offences and penalties relating to trademarks. There is also provision for the seizure and destruction of the goods (Article 84) and the protection extends to appellations of origin (Article 85).

Articles 106 and 107 of Patent Law No. 17.164 establish offences and penalties relating to patents as follows:

Article 106 establishes a penalty of six months to three years for anyone who defrauds another of rights protected by patents. It also provides for the seizure of the infringing products and the implements used in making them.

Article 107 increases this penalty to 15 months to four years in the following aggravating circumstances: (a) where the infringer was an employee of the patent owner or a licensee; and (b) where he obtained from these latter knowledge of the special methods of producing the patented product.

2. What protection does your copyright legislation afford to "foreign works"?

According to Article 4 of our current Copyright Law (No. 9.739 of 17 December 1937): "The legal protection of this right (i.e. copyright) shall be accorded in all cases and to the same extent, whatever the nature or origin of the work or the nationality of its author and without distinction as to school, denomination or philosophical, political or economic tendency."

Thus, the principle of national treatment has long been enshrined in our system of positive law. Accordingly, in Uruguay a foreign work is accorded exactly the same protection as a national

work. This protection is afforded and made effective by establishing moral and economic rights in favour of the author and civil and criminal procedures for dealing with infringements.

Moreover, Uruguay has approved the Berne Convention for the Protection of Literary and Artistic Works (Paris Act of 1971), through Law No. 14.910 of 24 July 1971.

Likewise, through Law No. 16.671, it has also approved the agreements resulting from the GATT Uruguay Round (TRIPS).

III. REPLIES TO THE QUESTIONS POSED BY THE EUROPEAN COMMUNITIES AND THEIR MEMBER STATES

A. GENERAL PROVISIONS

1. Please describe if your legislation includes measures necessary to protect public health and nutrition, and to promote the public interest in sectors of vital importance to your socio-economic and technological development as mentioned under Article 8 of the TRIPS Agreement. If yes, please explain how such measures are consistent with the provisions of the TRIPS Agreement.

According to Article 55 of the new Patent Law No. 17.164 of 2 September 1999, in special situations that might affect the general interest, including the economic, social and technological development of certain sectors of strategic importance for Uruguay, as well as for urgent health reasons or other like reasons of public interest, the Executive Power may, by means of a special resolution, grant compulsory licences or other uses without the authorization of the patent owner, their scope and term being adapted to the purpose for which they were granted. Articles 56 to 59 lay down specific conditions and procedures for these uses, while the general conditions are set out in Articles 71 to 80.

B. COPYRIGHT AND RELATED RIGHTS

2. Please state how your legislation provides for the protection of the exclusive rights of authors in relation to their literary and artistic works, as specified in Article 9 of the TRIPS Agreement which requires Members to comply with Articles 1-21 of the Berne Convention and the Appendix to the Berne Convention (1971).

Uruguay approved the Berne Convention by Law No. 14.910 of 19 July 1979.

There have been judicial decisions relating to its application in Uruguay.

At the same time, Uruguayan copyright law provides broad protection for authors, granting them exclusive rights in various modes of exploitation of their works (Law No. 9.739 of 17 December 1937).

The application of the Berne Convention entails the automatic application of its various provisions, including derogation from the compulsory registration requirement of the 1937 Law, the extension of the period of *post mortem* protection to 50 years, the presumption of authorship, and the broad concept of communication to the public. The Berne Convention and the national legislation have coexisted peacefully and harmoniously, as expressly reflected in repeated decisions by the courts.

3. Please describe the protection accorded to authors of computer programs, databases or compilations of data.

Although computer programs and databases are not expressly included in the existing Copyright Law, in Uruguay they have long been treated as copyright-protected works by the Executive Power, in legal theory and by the courts.

The 1937 Law gives a list of examples of protected works, in the last paragraph of which it is indicated that the protection extends to "*any product of the intellect*" (Law No. 9.739, Article 5).

Lists of works are purely illustrative in scope.

The illustrative list in Article 5 is therefore completely consistent, with comparative law and especially with the Berne Convention.

Despite the lack of an express mention in the legislation, given its purely illustrative nature, the national authorities responsible for applying the copyright rules have agreed that computer programs should be protected through the copyright system. Thus, Executive Decree No. 154/989 of 11 April 1989 allowed computer programs to be registered as works, that is to say, within the framework of the copyright legislation.

As protected works, computer programs come under the general procedure, whether civil or criminal, concerning infringements of copyright.

According to authoritative Uruguayan legal writers and the legal precedents, despite not being expressly included in the Copyright Law, computer programs qualify for the civil and criminal protection afforded by Law No. 9.739.

The first court decision was handed down by the Administrative Court, which ruled that computer programs were products of the intellect and as such covered by Law No. 9.739. The civil and criminal courts have delivered judgements to the same effect. Today, the situation is being further consolidated by the provisions following from the approval of the TRIPS Agreement (Law No. 16.671).

4. Please state whether your legislation provides for a rental right and, if so, the works to which it applies.

There is no express provision for this right in the national legislation. However, it is incorporated in the draft law which has been approved by the Chamber of Representatives and is currently being considered in the Senate.

Thus, the rental right is included within the notion of public distribution and has been established in favour of authors in general and producers of phonograms.

5. Please describe the rights granted to performers, producers of phonograms (sound recordings) and broadcasting organizations under your legislation.

Performers enjoy the rights laid down in the 1937 Copyright Law. Basically, these rights comprise: the right to require payment for their performance when broadcast or retransmitted by radio or television or recorded or impressed on a disk, film, tape, wire or any other material or medium suitable for audio or visual reproduction. If no agreement can be reached, the amount of the payment shall be established in summary proceedings by the competent judicial authority (Article 36).

The performer of a literary or musical work may object to the disclosure of his performance if it is reproduced in such a way as to seriously or unfairly injure his artistic interests (Article 37).

Moreover, by Law No. 14.587 of 19 October 1976, Uruguay approved the Rome Convention, thereby affording the consequential rights to the holders described therein.

It should also be noted that Law No. 15.289 of 14 July 1982 created a category of criminal offence designed to protect producers of phonograms and/or videograms from unauthorized reproductions and including protection for performers.

According to Article 1, "Anyone reproducing a phonogram or videogram for gain and without the written authorization of its producer, and anyone distributing to the public or stocking for that purpose the reproductions thus obtained, shall be liable to the penalty laid down in Article 46 of Law No. 9.739 of 17 December 1937. The same penalty shall be applicable to anyone fixing the live performance of a literary or artistic work by any means, clearly for the purpose indicated in the previous sentence and without the written authorization of the author and the performer, as well as to anyone distributing to the public or stocking for that purpose the versions thus obtained."

6. Please state whether your legislation provides for any limitation or exception in relation to each of the rights described above in accordance with the relevant provisions of the Berne and Rome Conventions and in light of Articles 13 and 14.6 of the TRIPS Agreement.

The limitations and exceptions relating to copyright are those which result from Article 45 of Law No. 9.739. These are also understood to extend to the copyright regime.

7. Please state the terms of protection of each right described above and the work or subject-matter to which it applies.

As regards the term of protection, the only point of reference is the periods granted by the Rome Convention.

In the government bill approved by the Chamber of Representatives and currently being considered by the Senate, the term of protection is fixed at 50 years.

8. Please state how your legislation grants the retroactive protection provided pursuant to Article 18 of the Berne Convention (the obligation of which derives from Article 9 of the TRIPS Agreement) and Article 14.6 of the TRIPS Agreement.

The above-mentioned draft Copyright Law establishes the term of protection at 50 years. Article 152 of the draft states that "The rights in works and other productions protected under the previous law which have not entered the public domain shall be granted the longer terms of protection accorded by the present Law."

In Uruguay it has been agreed that since the approval of the Berne Convention the term of protection laid down in the Copyright Law (40 years) has been extended to 50 years.

When the draft receives legislative approval, performers, phonogram producers and broadcasting organizations will obtain an extension of the term of protection laid down in the Rome Convention, since they will also be granted a term of 50 years.

9. Please explain whether the *droit de suite* provided for in Article 14^{ter} of the Berne Convention is protected in your legislation.

Article 9 of Law No. 9.739 establishes the *droit de suite* in general form. It reads: “In any disposal there shall be understood to have been reserved, in favour of the disposing author, the right to share in the appreciation of the work, in the profits made by successive purchasers. Any agreement to the contrary shall be null and void. In each case the percentage of the profit shall be 25 per cent. In the event of a collaboration or if there is more than one author, the said percentage shall be divided equally between the interested parties, unless otherwise agreed. On the death of the author, his heirs and assigns shall retain the same right until the work enters the public domain.”

C. TRADEMARKS

10. Please give the definition of a sign under your national legislation and explain under what conditions it is protectable.

According to Article 1 of Law No. 17.011 of 25 September 1998 on trademarks and other distinctive signs: “Trademark means any sign capable of distinguishing the goods or services of one natural or legal person from those of other natural or legal persons.” Article 2 includes non-visible signs, Article 3 advertising slogans, Articles 38 to 43 collective marks, and Articles 44 to 56 certification marks.

11. Please confirm whether or not services are a protectable subject-matter in your trademark law. Please confirm if signs, such as trade names, are protectable. Please describe if elements such as sound, perfumes and containers are protectable.

As mentioned in the previous reply, service marks are protected by the Law. Moreover, Articles 67 to 72 protect trade names, without registration. As for non-visible signs, as already mentioned, they are protected by Article 2 of the Law and Executive Decree No. 146/01 provides for the registration of marks in the form of sounds.

12. Please explain what the requirements of use are, if any, as a condition for a trademark registration. Please explain the definition of use and the conditions of maintenance of a registration in that respect.

The use of a trademark is optional (Article 19). It may, however, be made compulsory for reasons of public interest or by executive decree.

13. Please confirm whether or not your legislation permits that the registration of trademarks be indefinitely renewable.

Article 18 provides for a ten-year period of protection renewable indefinitely.

14. Please describe the special requirements, if any, prescribed by your legislation concerning the use of a trademark.

As already explained, Uruguay does not require such use.

D. GEOGRAPHICAL INDICATIONS

15. Please explain whether or not your trademark registration authority refuses a trademark application if it contains a geographical indication.

Law 17.011 prohibits the registration as a trademark of appellations of origin, indications of source and any geographical name that is not sufficiently original and distinctive with regard to the goods or services to which it applies or whose use is liable to create confusion regarding the origin, source, qualities or characteristics of the goods or services for which the mark is used (Article 4(4)). Moreover, Chapter XII of the Law provides for special protection for geographical indications which, according to Article 73, consist of indications of source and appellations of origin. Article 74 defines an indication of source as the use of a geographical name on goods and/or services to identify the place of extraction, production or manufacture of a given product or the provision of a given service, considered as the place of source. Indications of source are protected without the need for registration. Article 75 defines an appellation of origin as the geographical name of a country, a city, a region or a locality used to designate a product or service whose qualities or characteristics are exclusively or essentially due to the geographical environment, including natural or human factors, while Article 76 establishes a register for such appellations and Article 77 lays down the requirements for their protection.

16. Please give the definition of a geographical indication in your legislation.

See reply to Question 15.

17. Please describe and explain the provisions of your legislation establishing a link, if any, between the characteristics of an indication and its geographical origin.

See reply to Question 15.

18. Please describe how additional protection is granted by your legislation to wines and spirits. Please mention other types of products, if any, covered by this additional protection.

The additional protection required by Article 23 of the TRIPS Agreement is included in the protection afforded by the rules mentioned in the reply to the previous question.

19. Please explain how exceptions under Article 24 of the TRIPS Agreement are used in your jurisdiction. Please provide examples of the use of the exceptions by courts or lists of names considered as generic in your jurisdiction.

Given the scope of the protection afforded by the Uruguayan legislation, no use has been made of the exceptions under Article 24 of the TRIPS Agreement.

E. INDUSTRIAL DESIGNS

20. Please explain whether or not your legislation extends to the protection of designs dictated essentially by technical or functional considerations. Please explain how textile designs are protected.

There is no special procedure in the Patent Law for the protection of textiles. However, given the time-limits, the possibility of early publication and the optional nature of the substantive examination to be carried out by the NIPD, the procedure for which the new Law provides (Articles 92 to 97) enables protection to be obtained relatively quickly, in accordance with Article 24.2 of the TRIPS Agreement.

(At the same time, it should be borne in mind that, in accordance with Article 87 of the Law 17.164, the protection conferred on industrial designs under the Law does not exclude or affect the protection that may be granted to the same design under other intellectual property protection regimes, which would include the parallel protection of the same design by copyright, provided it met the corresponding requirements.)

21. Please explain how your legislation protects right holders of a design against importing of articles bearing embodied or copied design.

Under Article 88 of Law No. 17.164, the owner of a patent for an industrial design has the right to prevent third parties from making, selling, offering for sale, using, importing or stocking for commercial purposes a product bearing a design reproducing his own design or like designs incorporating his design or differing from it only in minor respects.

22. Please state whether or not your legislation provides for the right to issue a compulsory licence for industrial designs.

Article 98 stipulates that the provisions on patents also govern industrial designs, insofar as they are applicable. Consequently, the rules concerning compulsory licences and other uses in Articles 54 to 88 authorize, in principle, the issuing of compulsory licences for industrial design patents, provided that one or other of the reasons for granting such licences applies.

23. Please indicate for what period of time your legislation grants protection for industrial designs.

Under Article 97 of the Law, the term of protection for industrial designs is 10 years from the date of filing of the application, with the possibility of an extension for a further 5 years at the request of the patent owner.

F. PATENTS

24. Please describe how your legislation defines the notions of: novelty, inventiveness and industrial application.

According to the first paragraph of Article 9 of Law No. 17.164, an invention will be considered new if it is not included in the state of the art. The second paragraph stipulates that the state of the art shall be held to comprise the sum of the technical knowledge made available to the public prior to the date of filing of the patent application or, where applicable, the recognized priority, by oral or written description, by use or by any other method of dissemination or communication of information, in Uruguay or abroad, in such a way that the invention can be made. Under the third paragraph, the content of an application being processed in Uruguay whose date of filing or, where applicable, priority is earlier than the date of the application being examined will also be held to form part of the state of the art, provided that the content was included in the prior application when it was published.

An invention is regarded as involving an inventive step when it does not result from the state of the art in a manner obvious to a person skilled in the art (Article 11).

An invention is regarded as capable of industrial application when its subject-matter can be used in industry, defined in the broadest sense (Article 12).

25. Please explain whether or not in your legislation, patent or otherwise, patent rights are enjoyed without any exclusions. If exclusions are provided for, please describe in detail how these exclusions are applied in legal as well as practical terms.

Article 39 of the Patent Law stipulates that the rights conferred by patents shall not extend to the following: acts carried out in private for non-industrial or non-commercial purposes, provided that they do not cause economic prejudice to the owner of the patent (subparagraph (a)); the preparation of a medicine for a single patient, according to a medical prescription and under the supervision of an authorized professional (subparagraph (b)); acts carried out solely for experimental purposes, including acts anticipating future commercial exploitation carried out during the year prior to the expiry of the patent (subparagraph (d)); acts carried out for teaching, scientific or academic research purposes (subparagraph (e)); the importation of small quantities of goods of a non-commercial nature contained in the personal effects of travellers or sent in small packages (subparagraph (f)). Accordingly, third parties may avail themselves of these uses without the authorization of the patent owner.

According to Article 41 of the Patent Law, owners of patents may not prevent acts carried out, even without disclosure, by third parties who, in good faith, on the date of filing of the application or priority, where applicable, were already manufacturing the product or using the process that forms the subject-matter of the invention in Uruguay, or had made serious preparations to manufacture, use or work it. Such acts may be continued only to meet the needs of the exploiting enterprise and the right is not transferable without the exploiting enterprise.

In accordance with the Constitution and other special laws, Articles 42 and 43 of the Patent Law provide for inventions made in authorized monopolies belonging to the State or to private individuals to be patentable. However, they may be industrially or commercially worked only with the agreement of the holder of the monopoly or after the monopoly has expired. Like any property right, in accordance with the Constitution, patent rights may be expropriated by the State. This requires a special law and the owner must be granted appropriate compensation under a judicial procedure with every guarantee.

According to the information available, there have been no instances of these rules having been applied in practice.

26. Please explain whether your legislation provides for the exclusion of inventions from patentability based on public order or morality. If so, please explain the relevant section of your legislation and explain its formulation. Please also explain if it has been applied in practice.

Under Article 14(b) of Patent Law No. 17.164 of 2 September 1999, in accordance with Article 27.2 of the TRIPS Agreement, inventions contrary to public order, morality, public health, the national food supply, security or the environment are not patentable.

There are no instances of this provision having been applied in practice.

27. Please explain whether or not diagnostic, therapeutic and surgical methods are excluded from patentability in your legislation. If so, please explain the relevant section of your legislation and explain its formulation.

In accordance with Article 27.3(a) of the TRIPS Agreement, diagnostic, therapeutic and surgical methods for the treatment of humans or animals are excluded from patentability by Article 14(a).

28. Please explain whether or not plants, animals and essentially biological processes are excluded from patentability in your legislation. If so, please explain the relevant section of your legislation and explain its formulation.

In accordance with Article 27.3(b) of the TRIPS Agreement, Article 13(b) of the Patent Law establishes that plants and animals, other than micro-organisms, and essentially biological processes for the production of plants or animals, other than non-biological and microbiological processes, are not to be considered inventions for the purposes of the Law. Under subparagraph (g) of Article 13, biological or genetic material existing in nature is likewise not considered to be an invention.

From this it clearly follows that micro-organisms and non-essentially biological processes are patentable under the legislation.

Plant varieties are protected by special legislation based on the standards of the UPOV Convention, to which Uruguay is party. The 1978 version of this Convention was approved by Law No. 16.580 of 21 September 1994. Moreover, Law No. 16.811 of 21 February 1997 contains the national legislation on the protection of cultivars. Thus, Uruguay possesses an effective *sui generis* system for the protection of plant varieties.

29. Please describe how micro-organisms, non-essentially biological processes, microbiological processes and plant varieties are protected in your legislation. Please explain, in this respect, the relevant sections of your legislation.

See reply to Question 28.

30. Please explain how your legislation protects patent right holders against the importing and against the offering for sale of a patented invention.

Under Article 34 of the Law, in accordance with Article 28 of the TRIPS Agreement, patents confer on their owners the right to prevent third parties not having the owner's consent from any of the following acts: (a) where the patent has been granted for a product: from making, offering for sale, selling or using the product, or importing or stocking it for any of these purposes; (b) where the patent has been granted for a process: from using the process and from any of the acts cited in subparagraph (a) in respect of products obtained by the said process.

31. Please state if your legislation provides for patent product protection of pharmaceutical and agricultural chemical products. In the affirmative, please indicate the legal reference.

Article 8 of the Law states that inventions of new products or processes which involve an inventive step and are capable of industrial application are patentable. In its turn, Article 127 states that inventions of pharmaceutical and agricultural chemical products may not be patented until 1 November 2001.

That is to say that Uruguay, which under Article 3(c) of its former patent legislation (Law No. 10.089 of 12 December 1941) excluded these sectors from patentability, has made use of a shorter period than that provided for in Article 65.4 of the TRIPS Agreement for extending patent protection to these products.

32. Please clarify if the patent protection of a process, as provided for in your legislation, covers the product obtained directly by that process.

As follows from the reply to Question 30, under Article 34(b) of the Patent Law, the protection granted for a process patent covers products obtained by that process.

33. Please explain the additional conditions, if any, in your legislation other than the sufficient disclosure of the invention in Article 29 of the TRIPS Agreement (e.g. submission of justification for access to genetic material or prior informed consent to its use). If such additional conditions exist, please point out the relevant legislation and describe the additional conditions in detail.

Neither Patent Law No. 17.164 nor any other legislation imposes additional conditions of the kind mentioned, other than those of Article 29 of the TRIPS Agreement on the complete disclosure of the invention and information concerning the applicant's other applications and grants (Articles 22, 25 and 32 of the Law).

34. Please describe if your legislation provides for limited exceptions to the exclusive rights conferred by a patent. If affirmative, please make a reference to relevant legislation.

According to Article 39 of the Patent Law, the rights conferred by patents do not cover the following acts: acts carried out in private for non-industrial or non-commercial purposes, provided that they do not cause economic prejudice to the owner of the patent (subparagraph (a)); the preparation of medicine for a single patient, according to a medical prescription and under the supervision of an authorized professional (subparagraph (b)); acts carried out solely for experimental purposes, including acts anticipating future commercial exploitation, carried out during the year prior to the expiry of the patent (subparagraph (d)); acts carried out for teaching, scientific or academic research purposes (subparagraph (e)); the importation of small quantities of goods of a non-commercial nature contained in the personal effects of travellers or sent in small packages (subparagraph (f)). Consequently, third parties may make these uses without the authorization of the patent owner.

Article 41 of the Patent Law states that owners of patent's may not prevent acts carried out, even without disclosure, by third parties who, in good faith, on the date of filing of the application or priority, where applicable, were already manufacturing the product or using the process that is the subject-matter of the invention in Uruguay, or had made serious preparations to manufacture, use or work it. Such acts may be continued only to meet the needs of the exploiting enterprise and the right is not transferable without the exploiting enterprise.

In accordance with the Constitution and other special laws, Articles 42 and 43 of the Patent Law provide for inventions made in authorized monopolies belonging to the State or to private individuals to be patentable. However, they may be industrially or commercially worked only with the agreement of the holder of the monopoly or after the monopoly has expired. Like any property right, in accordance with the Constitution, patent rights may be expropriated by the State. This requires a special law and the owner must be granted appropriate compensation under a judicial procedure with every guarantee.

35. Please explain whether or not your legislation provides for compulsory licensing. If so, please explain in detail the conditions under which a compulsory licence may be granted. In particular, please explain how your national legislation considers individual merits in the authorization of such use.

Articles 54 to 80 of the Patent Law (PL) authorize the granting of compulsory licences for various reasons: non-exploitation (Article 54), public interest (Articles 55 to 59), anti-competitive practices (Articles 60 to 63), unjustified refusal of a contractual licence (Articles 64 to 68), and dependent patents (Articles 69 and 70). The Law also contains a Chapter on general provisions and procedures (Articles 71 to 80) relating to compulsory licences. These articles lay down conditions for the granting of compulsory licences in accordance with Article 31 of the TRIPS Agreement.

Below, the corresponding provisions of the Patent Law are described in detail in the order of the paragraphs of Article 31 of the TRIPS Agreement:

- (a) The circumstances and requirements for the granting of licences for non-exploitation, reasons of public interest, anti-competitive practices, unjustified refusal of a contractual licence, and dependent patents are defined in Articles 54, 55, 60 and 61, 64, and 69 and 70, respectively.
- (b) Article 71 of the Patent Law lays down the requirements that persons wishing to obtain a compulsory licence must meet. Thus, they must have: requested a contractual licence from the owner of the patent and been unable to obtain it on fair commercial terms customary in Uruguay, within 90 days following the request. Under the second paragraph of Article 71, this requirement may be waived in situations of national emergency, extreme urgency, or in cases of non-commercial public use and anti-competitive practices.
- (c) From the provisions of Article 77 of the Patent Law, subparagraphs (a) and (c), as well as from the provisions cited in (a) above and those relating to the various types of compulsory licences (for example, Article 58 concerning public interest) it clearly follows that their scope and duration are limited to the purpose for which they were granted.
- (d) Article 73 (a) of the Patent Law clearly establishes that compulsory licences may not be exclusive.
- (e) According to Article 73(d) of the PL, a compulsory licence may not be assigned without that part of the enterprise or goodwill which exploits the subject-matter of the licence.
- (f) Article 56 of the PL establishes that in the case of compulsory licences for reasons of public interest, the supply will be exclusively to meet the needs of the domestic market.
- (g) Under Article 59 of the PL, uses granted under a compulsory licence may be withdrawn, subject to appropriate protection of the legitimate interests of the persons who have received the authorization, if the circumstances which gave rise to the authorization have ceased to exist and are unlikely to recur. The competent authorities are empowered to examine whether such circumstances still exist, on receiving a substantiated request.
- (h) Article 77(b) establishes that, in general, the licensor will be remunerated and that the amount of remuneration will be fixed according to the circumstances specific to each case, taking into account the economic value of the exploitation of the licensed invention, as well as other factors such as average royalties for the sector under commercial licensing agreements.
- (i) The resolutions granting compulsory licences are issued by the National Industrial Property Directorate (NIPD) or by the Executive Power, in the case of licences for reasons of public interest. Both resolutions may be reviewed, upon application for reconsideration or appeal to a higher administrative authority in the case of the NIPD, an agency subordinate to the Executive Power. After that, under the Constitution and

special laws, any final State resolution may be set aside by the Administrative Tribunal, a specialized five-member quasi-judicial body.

- (j) According to Article 74 of the PL, if the parties are unable to agree on the appropriate remuneration or the other conditions for the granting of a compulsory licence, an arbitral tribunal shall be appointed to decide the matter. Its decision will be adopted by a resolution of the NIPD (Article 75) granting the licence. Consequently, as the fixing of the remuneration forms part of the NIPD decision granting the licence, it can be reviewed in the same way as the latter, i.e. by recourse to the appropriate administrative remedies and then by an action to set aside before the Administrative Tribunal, as described in the preceding paragraph.
- (k) The second paragraph of Article 71 states that in the case of compulsory licences for anti-competitive practices (Articles 60 to 63 of the PL), the interested party, the potential user, may disregard the requirements imposed by the first paragraph in other cases.
 - (i) According to Article 60 of the PL, a compulsory licence may be granted for anti-competitive practices if the competent authority, following administrative or judicial procedures that confer on the patent owner the right to a fair hearing and other guarantees, has previously determined that the owner has been involved in practices deemed anti-competitive or has abused the rights conferred by the patent or a dominant market position.
 - (ii) Although the PL does not specifically provide for the correction of anti-competitive practices as a factor to be taken into account in fixing the amount of remuneration, inasmuch as the Law grants the competent authorities powers to determine that amount and to refuse to withdraw the authorization if the circumstances which gave rise to it are likely to recur, it is clear from the provisions as a whole that the authorities must take this factor into account. Thus, for example, Article 62 of the PL states that if the owner of the patent continues the acts or practices that led to the determination of anti-competitive practices or abuse of the rights conferred by the patent, the right to the patent may be cancelled, either ex officio or at the request of an interested party, subject to a prescribed period of notice.
- (l) As already mentioned, Articles 69 and 70 of the PL deal with the subject of “dependent patents”. According to Article 69, if a patented invention or utility model cannot be exploited without infringing an earlier patent, the owner or a licensee may request the grant of a compulsory licence in respect of the other patent, insofar as it is necessary to work the patent and avoid infringement. Article 70 lays down the conditions for the granting of this type of compulsory licence, namely: the invention claimed in the second patent must involve an important technical advance of considerable economic significance in relation to the invention claimed in the first patent (subparagraph (a)); the owner of the first patent must be entitled to obtain a cross licence on reasonable terms to use the invention claimed in the second patent (subparagraph (b)); and assignment of the authorized use of the first patent must include use of the second patent (subparagraph (c)).

The other requirements of Article 31 of the TRIPS Agreement concerning notification of the patent holder as soon as reasonably practical when compulsory licences are granted in situations of national emergency (subparagraph (b)); the informing of the right holder in cases of public non-commercial use; the restriction of compulsory licences for semi-conductor technology to cases of

public non-commercial use or the remedying of anti-competitive practices (subparagraph (c)); and, in part, use predominantly for the supply of the domestic market are not specifically provided for in the PL. However, they are mandatory by application of the general principles laid down in the legislation, such as those requiring that the patent holder be notified or informed, or because the provisions of the TRIPS Agreement itself so require, since, as has repeatedly been pointed out, these provisions have been incorporated into the national legislation and form part of domestic law, for example Law No. 16.671 of 13 December 1994 on semi-conductor technology.

As regards the conditions that must be met by the licensee, Article 72 stipulates that, in general, anyone seeking a compulsory licence or other unauthorized uses must possess the technical and economic capacity and the infrastructure needed to start exploiting the invention.

36. Please explain how your legislation explicitly ensures that a proposed user has made efforts to obtain authorization from the right holder on reasonable commercial terms and conditions and that such efforts have not been successful within a reasonable period of time. In this context, how do you define "reasonable period of time". Please also explain how your legislation ensures that the use of a compulsory licence shall be authorized predominantly for the supply to the domestic market of the Member authorizing such use.

As indicated in the reply to the previous question, Article 71, in accordance with Article 31 of the TRIPS Agreement, states that persons wishing to obtain a compulsory licence or other uses must provide evidence that they have requested a contractual licence from the owner of the patent and have been unable to obtain one on fair commercial terms customary in Uruguay within 90 days of making the request. This requirement may be waived in situations of national emergency or in cases of public non-commercial use and anti-competitive practices.

Although the requirement of Article 31(f) of the TRIPS Agreement that compulsory licences and other uses be granted predominantly for the supply of the domestic market is not specifically mentioned in the Law, as also noted in the reply to the previous question, it forms part of the national legislation as a result of the incorporation of the provisions of the Agreement into domestic law. At the same time, the very nature of the conditions and requirements laid down in the Law for the granting of compulsory licences presupposes that its main purpose is to supply the domestic market, except in the case of licences for remedying anti-competitive practices under Article 31(k).

37. Please state if your legislation grants additional protection for innovations after the 20 years of patent protection has lapsed.

In accordance with Article 33 of the TRIPS Agreement, Article 21 of the Law states that the term of protection for patents for inventions shall be 20 years as from the application filing date, while making no provision for extensions.

38. Please explain how your legislation provides for the reversal of the burden of proof in relation to process patents.

In accordance with Article 34 of the TRIPS Agreement, Article 101 of the PL establishes that in civil proceedings if the subject-matter of the patent is a process for obtaining a product, the judicial authorities shall have the authority to order the defendant to prove that the process to obtain the product is different from the patented process, provided that the product is new.

G. LAYOUT-DESIGNS (TOPOGRAPHIES) OF INTEGRATED CIRCUITS

39. Please describe how your legislation protects topographies.

As repeatedly noted, Uruguay's ratification of the TRIPS Agreement incorporated its provisions, and in particular Articles 35 to 38 concerning integrated circuits, into domestic law.

Thus, the reference in Article 35 of the TRIPS Agreement to Articles 2 through 7 (other than paragraph 3 of Article 6), Article 12 and paragraph 3 of Article 16 of the Treaty on Intellectual Property in Respect of Integrated Circuits also incorporates these provisions into domestic law, rendering them mandatory. Therefore, without prejudice to the possibility of their direct individual application, they constitute a positive source of integration and interpretation additional to the specific rules of the legislation on patents, industrial designs, copyright and unfair competition adopted to protect layout-designs of integrated circuits, according to the circumstances, or prevent acts of unfair competition that might affect their creators.

In accordance with the above and Article 4 of the Integrated Circuits Treaty, layout-designs that meet the corresponding requirements for acquisition of each type of right may acquire protection through patents, industrial designs or copyright, or through the rules on unfair competition.

40. Please explain what protection your national legislation grants to right holders against the unlawful importation, sale or distribution for commercial purposes of topographies including integrated circuits or other articles in which a topography is incorporated in accordance with Article 36 of the TRIPS Agreement.

The protection provided for patents and industrial designs and for copyright, together with the general provisions of civil and procedural law, by application of the general principles or the rules on unfair competition, confer on the right holder and creator of the layout-design civil remedies and provisional measures for protecting his right.

The type of protection for layout-designs of integrated circuits will depend on the type of intellectual property right to whose protection they can lay claim: patents, industrial designs or copyright, or may take the form of actions to protect the designer of the circuit from unfair competition or, in general, from any unlawful acts of a third party that cause him injury.

41. Please explain how your legislation provides for the derogation from Article 36 as specified in Article 37 of the TRIPS Agreement where a person has no knowledge or reasonable grounds to know when acquiring an integrated circuit or an article incorporating such an integrated circuit that it contains an unlawful topography.

As already pointed out, the provisions of Articles 36 and 37 of the TRIPS Agreement form part of Uruguay's domestic law.

42. Please state the term of protection granted by your legislation to topographies.

In accordance with the reply to Question 40, the term of protection for layout-designs of integrated circuits will depend on the type of intellectual property right to whose protection they can lay claim: patents, industrial designs or copyright. However, this term will always be greater than the minimum of 10 years specified in Article 38 of the TRIPS Agreement.

H. PROTECTION OF UNDISCLOSED INFORMATION

43. Please explain whether or not your legislation grants a defined period of time for the protection of undisclosed information. If so, please give the time span.

Like the other provisions of the TRIPS Agreement, the provisions of the Paris Convention (Stockholm Act of 14 July 1967), and in particular those of its Article 10*bis* on unfair competition, have been incorporated into Uruguay's domestic law, following ratification by Decree-Law No. 14.910 of 10 July 1979.

Consequently, by application of these provisions and, moreover, the general rules and principles of civil law, persons who have lawfully within their control information that fulfils the requirements of Article 39.2 of the TRIPS Agreement may prevent it from being disclosed to, acquired by, or used by others in a manner contrary to honest commercial practices.

With regard to undisclosed test or other data submitted to the competent authority as a condition of approval of the marketing of pharmaceutical or agricultural chemical products, provided they meet the requirements of Article 39.3 of the TRIPS Agreement, they will be protected against unfair commercial use. Moreover, Article 197 of Law No. 17.296 stipulates that officials of the Ministry of Livestock, Agriculture and Fisheries who obtain information in the course of their inspection activities must keep that information secret and preserve the confidentiality of any administrative or judicial proceedings of which they have knowledge.

At the same time, Article 6 of Executive Decree No. 324/999 of 12 October 1999 on the approval of the marketing of pharmaceutical products states that the applicant must declare the undisclosed nature of information provided for the purpose of obtaining authorization.

44. Please explain how your legislation defines "undisclosed information".

See reply to Question 43.

45. Please explain how your legislation defines data submitted to governments or governmental agencies.

See reply to Question 43.

I. ENFORCEMENT

46. Please describe how your legislation provides for effective action against infringement of intellectual property rights.

Copyright and related rights

Firstly, Article 46 of Copyright Law No. 9.739, as amended by Article 23 of Law No. 15.913 of 17 November 1987, stipulates that: "Whoever publishes, sells, reproduces or causes to be reproduced by any means, in whole or in part, an unpublished or published work without the written authorization of its author or his successor in title or its purchaser, in whatever capacity, or attributes it to a different author, thereby contravening the provisions of this Law, shall be liable to a term of from three months' to three years' imprisonment."

Secondly, Law No. 15.289 of 14 July 1982 introduced a new criminal offence with a view to protecting producers of phonograms and/or videograms from unauthorized reproductions.

According to Article 1, “Anyone reproducing a phonogram or videogram for gain and without the written authorization of its producer, and anyone distributing to the public or stocking for that purpose the reproductions thus obtained, shall be liable to the penalty laid down in Article 46 of Law No. 9.739 of 17 December 1937. The same penalty shall be applicable to anyone fixing the live performance of a literary or artistic work by whatever means, clearly for the purpose indicated in the previous sentence and without the written authorization of the author and the performer, as well as to anyone distributing to the public or stocking for that purpose the versions thus obtained.”

Article 47 of Copyright Law No. 9.739 of 17 December 1937, as amended by Article 328 of Law No. 16.170 of 27 December 1987, stipulates that:

“The unlawfully reproduced copies and any materials used for reproduction, communication or public performance shall be seized.

As a preparatory measure, the interested party may request their attachment and, where good cause can be shown, apply to the competent court for exemption from counter-security.

The judgement shall, in all cases, order the destruction or disablement of the copies and materials seized, if these are able to be used, to the extent necessary to prevent unlawful exploitation.

Copies acquired by third parties in good faith for their personal use shall not be destroyed.”

Industrial property

There are expeditious administrative and judicial remedies to deter any infringement.

From the administrative standpoint, both Trademark Law No. 17.011 and its Regulatory Decree No. 34/99 and Patent Law No. 17.164 and its Regulatory Decree No. 11/00 provide for special administrative procedures based on the latest standards.

From the judicial standpoint, Laws Nos. 17.011 and 17.164, Articles 81 to 85 and 106 and 107, respectively, establish offences and penalties for infringers of industrial property rights, namely, trademarks and appellations of origin, in the first instance, and patents, utility models and industrial designs, in the second.

Likewise, Articles 87 and 88 of Law No. 17.011 and 99 to 105 of Law No. 17.164 provide for civil proceedings for infringements of the trademark and patent regulations.

All these procedures, both administrative and judicial, whether civil or criminal, are based on the constitutional principle of due process. The administrative procedures are laid down in special laws and decrees such as Decree No. 500/91, which applies to the Uruguayan public service in general. Civil proceedings are governed by the General Code of Procedure and criminal proceedings by the Code of Criminal Procedure.

47. Please explain whether or not your legislation provides for a mechanism to appeal to judicial bodies of final administrative decisions.

Copyright and related rights

Under both judicial and administrative procedures there are mechanisms for appealing decisions of the bodies concerned.

Industrial property

Where administrative decisions are concerned, they may be reviewed by a specialized five-member quasi-judicial body (Administrative Tribunal).

48. Please describe how your legislation authorizes judges to order production of evidence by the opposing party. Please give precise information on what measures are taken to ensure the protection of confidential information.

Copyright and related rights

This judicial authority may be regarded as covered by the general and particular rules of procedure.

Thus, Article 168 of the General Code of Procedure (Law No. 15.982 of 18 October 1988) on documents within the control of the opposing party states: "A party wishing to make use of a document which it declares to be within the control of the opposing party may request the court to order the latter to produce it within the period it shall determine.

If other evidence clearly shows the probable existence and content of the document, refusal to produce it shall be regarded as acknowledgement of that content."

In this respect, reference may also be made to Article 189 of the Code, entitled "Cooperation in the taking of evidence", paragraph 3 of which states: "If one of the parties is required to cooperate and unjustifiably refuses to do so, the court may order its cooperation. If, despite that, it should continue in its recalcitrance, the court may order that the formalities be waived and the refusal to cooperate interpreted in the evidence as confirmation of the accuracy of the statements of the opposing party with regard to the fact it is desired to prove, in the absence of proof to the contrary."

Industrial property

Article 168 of the GCP allows the plaintiff to request that the opposing party be ordered to produce documentation within his control which the plaintiff wishes to use. Refusal may be regarded as acknowledgement of content. As regards the identification and protection of confidential information, if the party required to provide it can justify its request for confidentiality, the court may take the steps necessary to protect it. Likewise, the law makes express provision for its protection in criminal inquiry proceedings under the CCP and in the confidential precautionary measures provided for under the GCP, etc.

49. Please quote provisions of your legislation that authorize judges to order a defendant to desist from an infringement.

Copyright and related rights

The copyright law contains no specific provision for suspending the infringing activity or prohibiting its resumption. There is such a provision in the draft law approved by the Chamber of Representatives and now before the Senate (Article 139).

Nevertheless, it is considered that, on the basis of the General Code of Procedure, measures of this type could be taken as precautionary measures or during proceedings.

Industrial property

Article 87 of Trademark Law No. 17.011 and Articles 99, 100 and 102 of Patent Law No. 17.164 authorize the ordinary courts to order infringers of industrial property rights to pay damages where there is fault or fraud. The payment of costs and charges may be ordered only in cases of bad faith or culpable negligence. Articles 1.319, 1.323 and 1.324 of the Civil Code provide, in general, for liability and the payment of damages in cases of fault or fraud.

50. Please quote what provisions of your legislation authorize judges to order the payment to the right holder of adequate damages to compensate the injury he suffered.

Copyright and related rights

Article 51 of Law No. 9.739 provides for civil proceedings for damages and for the imposition on infringers of a civil penalty consisting of the profits or income improperly received. Thus, in accordance with the Law in force, as reflected in Uruguayan legal theory and precedents, infringers are liable not only for damages (consequential damages and loss of income) but also for all profits or income improperly received as a result of the unlawful exploitation of the work.

Industrial property

See reply to Question 49.

51. Please quote what provisions of your legislation authorize judges to order the payment of the right holder's expenses by the infringer.

Copyright and related rights

This matter is governed by the general provisions of the Code of Civil Procedure (Articles 56 *et seq.*).

Article 56 of the Code, on orders in final judgements, states that the latter shall order the payment of costs and charges or not make any special order, as appropriate, in accordance with the provisions of Article 688 of the Civil Code. Costs are considered to include all taxes, including payment of the *vicesima*, and the fees of experts, depositaries, valuers and other officers of the court. Charges are considered to include attorneys' fees.

Industrial property

An order to pay costs and charges may be made only in the event of bad faith or culpable negligence.

52. Please explain if and how judges have the authority to order that infringing goods are placed outside channels of commerce or destroyed.

Copyright and related rights

Article 47 of Copyright Law No. 9.739 of 17 December 1937, as amended by Article 328 of Law No. 16.170 of 27 December 1987, stipulates that:

“The unlawfully reproduced copies and any materials used for reproduction, communication or public performance shall be seized.

As a preparatory measure, the interested party may apply for their attachment, while requesting the competent court for exemption from counter-security, where there is good cause.

The judgement shall, in all cases, order the destruction or disablement of the copies and materials seized, if these are able to be used, to the extent necessary to prevent unlawful exploitation.

Copies acquired by third parties in good faith for their personal use shall not be destroyed.”

Industrial property

In cases of infringement, under Article 84 of Trademark Law No. 17.011 trademarks and the implements used in making them will be destroyed or rendered unusable and infringing goods that have been seized will be forfeited and destroyed, unless they can be awarded to public or private charitable institutions. Article 106 of Patent Law No. 17.164 provides for the forfeiture of infringing articles and the implements used in making them and their disposal in consultation with the NIPD.

53. Please quote what provisions of your legislation authorize judges to indemnify a defendant in the event of abuse by the plaintiff.

Copyright and related rights

This situation would have to be studied in terms of the situations relating to abuse of rights or abuse of process.

There is no specific provision for this in the Copyright Law.

Industrial property

This possibility is always available where injury can be shown to have resulted from the abuse of process. Moreover, if reckless malice can be proved, the plaintiff may be ordered to pay the costs and charges.

54. Please explain how your legislation implements Article 50 of the TRIPS Agreement.

Copyright and related rights

Article 50 may be regarded as a series of self-enforcing rules since it authorizes the judicial authorities to order the provisional measures described therein.

Without prejudice to these provisions, it should be noted that Articles 306 *et seq.* of the General Code of Procedure also provide for a series of “preparatory measures” applicable to any proceedings. Thus:

“Any proceedings may, at the initiative of a party, include a preliminary phase for the purpose of:

- (1) determining or completing the active or passive legitimation of the parties to the future proceedings;
- (2) expediting the taking of evidence which might be lost if action were postponed to a later stage;

- (3) serving notices to establish default and obtaining elements needed for the proceedings such as documents, accounts and the like;
- (4) ordering precautionary measures or the provision of security in connection with the subsequent proceedings.

Articles 311 *et seq.* also establish precautionary measures.”

Industrial property

Article 50 of the TRIPS Agreement is implemented as follows: with respect to Article 50.1, Article 103 of Patent Law No. 17.164 provides for the adoption of provisional or precautionary measures in accordance with the General Code of Procedure, Article 317 of which concerns provisional measures, laying down the same procedure as for precautionary measures (Articles 311 to 316). For the preservation of evidence, in addition to these articles, Article 309.6 on preliminary measures also applies. With respect to Article 50.2, Article 315 of the GCP provides for measures of this type to be ordered without the knowledge or intervention of the other party. With respect to Article 50.3, Articles 314.2 and 314.3 of the GCP require the production of *prima facie* evidence and the provision of counter-security and the adoption of the measure is decided as soon as the evidence has been examined. With respect to Article 50.4, Article 315 of the GCP provides for notification of the measure immediately upon execution, and both the person affected by the measure and the applicant may appeal the decision. With respect to Article 50.5, the court may always request further evidence of the right in order to facilitate its decision. This is a general procedural principle enshrined in the GCP. With respect to Article 50.6, Article 311.2 of the GCP provides for precautionary measures to lapse automatically if a complaint is not lodged within 30 days and for the applicant to be ordered to pay all the costs of the proceedings and any damages. With respect to Article 50.7, as already mentioned in connection with the previous article, compensation for injury is provided for in Article 311.2 of the GCP. With respect to Article 50.8, provisional measures may be ordered under administrative procedures, since Decree No. 500/91 on administrative procedures authorizes the application of the GCP, wherever relevant.

55. Please identify the competent authorities in your jurisdiction who receive requests from right holders for an application to suspend the release of counterfeit goods by the customs authorities.

Copyright and related rights

Under the Uruguayan legal system, the party affected may request the courts to apply precautionary measures where there is a possibility of counterfeit or unlawfully reproduced goods entering the country.

The National Directorate of Customs has acted *ex officio* in several proceedings relating to unlawfully reproduced goods.

As for the present Copyright Law, it does not contain any express provisions. The draft law, approved with amendments in the Chamber of Representatives and currently being considered in the Culture Committee of the Chamber of Senators, incorporates the following Article 137:

“Holders of intellectual property rights who have valid grounds for suspecting that attempts or preparations are being made to import into the national territory goods which, in accordance with the terms of the applicable legislation, have been manufactured, distributed or imported, or are intended for distribution, without the authorization of the holder of the intellectual property right may request the competent customs or judicial authorities to order special control measures in respect of those

goods, their preventive attachment or the precautionary suspension of the corresponding customs procedure. Evidence justifying the suspicions must be produced.

If the request is made to the National Directorate of Customs, the latter, having ordered the precautionary measures requested, shall promptly notify the importer and the applicant. If within 10 working days of notification of the right holder or his representative, no evidence of initiation of the corresponding civil or criminal proceedings has been received, the preventive measures shall be revoked and the goods released, without prejudice to any liabilities that may have been incurred by an applicant who has knowingly lodged an unfounded complaint.”

Industrial property

The customs courts.

56. Please indicate whether or not procedures are available to suspend the exporting of counterfeit goods.

Copyright and related rights

Under the Uruguayan legal system, the party affected may request the courts to apply precautionary measures where there is a possibility of counterfeit or unlawfully reproduced goods being exported

Industrial property

There are no such procedures.

57. Please indicate whether or not your legislation provides for a *de minimis* imports exception.

Copyright and related rights

This provision has not been implemented.

Industrial property

There are no such procedures.

58. Please explain how your legislation implements Article 61 of the TRIPS Agreement.

Copyright and related rights

In the criminal law there are two provisions relating to copyright and related rights.

Firstly, Article 46 of Law No. 9.739, the Copyright Law, as amended by Article 23 of Law No. 15.913 of 17 November 1987, stipulates that: “Whoever publishes, sells, reproduces or causes to be reproduced by any means, in whole or in part, an unpublished or published work without the written authorization of its author or his successor in title or its purchaser, in whatever capacity, or attributes it to a different author, thereby contravening the provisions of this Law, shall be liable to a term of from three months' to three years' imprisonment.”

Secondly, Law No. 15.289 of 14 July 1982 introduced a new criminal offence with a view to protecting producers of phonograms and/or videograms from unauthorized reproductions.

According to Article 1, “Anyone reproducing a phonogram or videogram for gain and without the written authorization of its producer, and anyone distributing to the public or stocking for that purpose the reproductions thus obtained, shall be liable to the penalty laid down in Article 46 of Law No. 9.739 of 17 December 1937. The same penalty shall be applicable to anyone fixing the live performance of a literary or artistic work by whatever means, clearly for the purpose indicated in the previous sentence and without the written authorization of the author and the performer, as well as to anyone distributing to the public or stocking for that purpose the versions thus obtained.”

Complaints for infringement of copyright may be prosecuted *ex officio* or through public right of action.

At the same time, it should be pointed out that a draft law establishing a new regulatory framework for copyright has been approved by the Chamber of Representatives and is currently being considered in the Chamber of Senators. Article 146 of the draft law establishes a new criminal offence characterized as follows: “Whoever, without the authorization of their author or respective owner protected by this Law, introduces works, performances, phonograms or broadcasts into a data storage system for the purpose of reproducing or distributing them shall be liable to imprisonment for three to 24 months.”

Industrial property

Article 61 of the TRIPS Agreement is implemented as follows:

Articles 81 to 83 of Trademark Law No. 17.011 establish offences and penalties relating to trademarks. There is also provision for the forfeiture and destruction of goods (Article 84) and the protection is extended to appellations of origin (Article 85).

Articles 106 and 107 of Patent Law No. 17.164 establish offences and penalties relating to patents, characterizing them as follows:

Article 106 provides for a term of six months' to three years' imprisonment for anyone who infringes any of the rights protected by patents. It also provides for the forfeiture of the infringing products and the implements used in making them.

Article 107 increases the term of imprisonment to 15 months to four years in the following aggravating circumstances: (a) where the infringer was an employee of the patent owner or a licensee and (b) where he obtained from the latter knowledge of the special methods of making the patented product.

IV. REPLIES TO THE QUESTIONS POSED BY THE UNITED STATES

A. GENERAL PROVISIONS

1. Please describe, in relation to each form of intellectual property covered by the TRIPS Agreement, including plant variety protection, the manner in which national treatment and most favoured nation treatment are provided to nationals of other WTO Members.

By Law No. 16.671 of 17 December 1995, Uruguay ratified the TRIPS Agreement, thereby incorporating its provisions into the national legislation to form part of its domestic law. Consequently, Articles 3 and 4 of the Agreement concerning national treatment and most-favoured-nation treatment apply in Uruguay.

Earlier, moreover, by Decree-Law No. 14.910 of 10 July 1979, Uruguay had ratified the Paris Convention for the Protection of Industrial Property (Stockholm Act 1967). Article 2 of this Convention also incorporates the principle of national treatment for nationals of Paris Union countries.

Thus, these rules are generally applicable to all the intellectual property subject-matter covered by the treaties in question.

Furthermore, the specific national legislation relating to each different type of rights makes no distinction between nationals and foreigners.

With regard to the principle of most-favoured-nation treatment, Uruguay applies it in accordance with the scope of Articles 4 and 5 of the Agreement and the exceptions contained therein.

B. COPYRIGHT AND RELATED RIGHTS

2. Please explain whether and how the copyright law of Uruguay complies with Article 9 of the TRIPS Agreement requiring that Members comply with all Articles 1 through 21 of the Berne Convention (1971), except Article 6^{bis}, since Members do not have rights or obligations relating to the latter Article under the TRIPS Agreement.

Uruguay approved the Berne Convention by Law No. 14.910 of 19 July 1979.

There have been judicial decisions relating to its application in Uruguay.

At the same time, Uruguayan copyright law provides broad protection for authors, granting them exclusive rights in various modes of exploitation of their works (Law No. 9.739 of 17 December 1937).

The application of the Berne Convention entails the automatic application of its provisions such as, among others, derogation from the compulsory registration requirement of the 1937 Law, the extension of the period of *post mortem* protection to 50 years, the presumption of authorship, and the broad concept of communication to the public. The Berne Convention and the national legislation have coexisted peacefully and harmoniously, as expressly reflected in repeated decisions by the courts.

3. Please explain how the copyright law of Uruguay protects computer programs as literary works and compilations of data as required by Article 10 of the TRIPS Agreement.

By Law No. 16.671, Uruguay approved the agreements resulting from the GATT Uruguay Round, including, in particular, the so-called TRIPS Agreement on intellectual property.

In view of the text of Article 10 of the TRIPS Agreement, there can be no doubt that computer programs and compilations of data are protected as “literary works”, i.e., under the relevant provisions of the law on literary and artistic property (Copyright Law No. 9.739).

The Uruguayan Government, legal theory and the case-law have long accorded protection to computer programs under the copyright legislation.

The first statutory recognition of computer programs under the copyright law came with Decree No. 154/989 of 11 April 1989. This Decree amended the article of the regulatory decree establishing the procedure for registering programs.

Thus, Article 19 reads: "In order to register photographs ... and computer programs two copies thereof shall be deposited. Copies of computer programs may be deposited in their entirety or in parts sufficient to characterize the creation of the program. Information provided in support of the registration of computer programs shall be confidential and may not be disclosed except for examination by the Copyright Council, at the request of the owner himself or by court order."

A very important ruling was that made by the Administrative Tribunal according computer programs the status of products of the intellect, thereby assuring them of protection under the copyright legislation (as literary and artistic property).

Under the criminal law, there have been several proceedings and convictions under the copyright legislation. Likewise in civil matters, the provisions of the Copyright Law and the Berne Convention concerning the awarding of damages, together with income and profits improperly received by the infringers, have been applied.

4. Article 11 of the TRIPS Agreement requires that rental rights for computer programs and cinematographic works be available. Please cite to the corresponding provision of the copyright law of Uruguay.

There is no express provision for this right in the national legislation.

However, it is incorporated in the draft law approved by the Chamber of Representatives and currently being considered in the Senate.

The rental right is included within the notion of public distribution and has been established in favour of authors in general and producers of phonograms.

5. Please state the length and terms of protection the copyright law of Uruguay provides for a work other than a photographic work or a work of applied art and cite to the relevant provision of law.

According to Article 14 of the Copyright Law, the general length of protection for a work is the lifetime of the author plus 40 years after his death.

Since the legislative approval of the Berne Convention (Law No. 14.910 of 1979), it has been generally understood that the length of protection has been extended to 50 years after death by application of the provisions of that Convention. That is to say, a tacit derogation from Law No. 9.739 (Copyright Law) has been accepted in this as in other respects.

The draft law approved by the Chamber of Representatives and currently being considered in the Senate increases the term of protection to 50 years.

6. Please describe the protection the copyright law of Uruguay provides for performers, and the term of the protection.

Performers enjoy the rights laid down in the 1937 Copyright Law. Basically, these rights comprise: the right to require payment for their performance when broadcast or retransmitted by radio or television or recorded or impressed on a disk, film, tape, wire or any other material or medium suitable for audio or visual reproduction. If no agreement can be reached, the amount of the payment shall be established in summary proceedings by the competent judicial authority (Article 36). The performer of a literary or musical work may object to the disclosure of his performance if it is reproduced in such a way as to seriously or unfairly injure his artistic interests (Article 37).

Moreover, by Law No. 14.587 of 19 October 1976, Uruguay approved the Rome Convention, thereby according the consequential rights to the holders described therein.

It should be noted that Law No. 15.289 of 14 July 1982 created a category of criminal offence that protects producers of phonograms and/or videograms from unauthorized reproductions and includes protection for performers.

According to Article 1, “Anyone reproducing a phonogram or videogram for gain and without the written authorization of its producer, and anyone distributing to the public or stocking for that purpose the reproductions thus obtained, shall be liable to the penalty laid down in Article 46 of Law No. 9.739 of 17 December 1937. The same penalty shall be applicable to anyone fixing the live performance of a literary or artistic work by any means, clearly for the purpose indicated in the previous sentence and without the written authorization of the author or artist, as well as to anyone distributing to the public or stocking for that purpose the versions thus obtained.”

As regards the term of protection, the only point of reference is the periods granted by the Rome Convention.

In the government bill approved by the Chamber of Representatives and currently being considered in the Senate, the term of protection is fixed at 50 years.

7. Article 14.2 of the TRIPS Agreement provides that producers of phonograms are to enjoy the right to authorize or prohibit the direct or indirect reproduction of their phonograms. Article 14.2 requires that producers of phonograms are to have the right to authorize or prohibit the commercial rental to the public of originals or copies of their phonograms. Please describe how the copyright law of Uruguay implements these obligations and indicate the term of protection.

The right to authorize or prohibit the direct or indirect reproduction of their phonograms is recognized as a result of the legislative approval of the Rome Convention.

As for the rental right, it is not expressly incorporated. There has been a court case in which it was ruled that the rental right is included in the right of distribution conferred by Article 1 of the above-mentioned Law No. 15.289.

C. TRADEMARKS

8. Please describe the subject-matter that can comprise a trademark under the trademark law of Uruguay.

According to Article 1 of Law No. 17.011 of 25 September 1998 on trademarks and other distinctive signs, “Trademark means any sign capable of distinguishing the goods or services of one natural or legal person from those of other natural or legal persons.” Article 2 includes non-visible signs, Article 3 advertising slogans, Articles 38 to 43 collective marks, and Articles 44 to 56 certification marks.

9. Please describe the procedure that must be followed to register a trademark in Uruguay, citing the relevant provisions of the law, and describe the rights that the owner of a registered mark can exercise.

The procedure for registering a trademark is laid down in Articles 29 to 37 of Law No. 17.011 and in Regulatory Decree No. 34/99. The procedure consists in the filing of a form containing the trademark application (which may be multi-class) accompanied by the necessary documents: letter-

proxy in the event of registration through an Industrial Property Agent or formal power of attorney, proof of payment of the prescribed fee, and the priority document, where applicable. Once the application has been filed, it is assigned a number and subjected to an initial formal examination, a period of 30 days being allowed for the production of any missing document. This period may be extended to 90 days where the priority document is concerned. If it passes this examination, the application is published in the Industrial Property Bulletin. Within 30 days of publication third parties may file any objections they consider relevant. The NIPD then carries out a second formal examination, allowing 10 days for the remedying of defects, and a substantive examination. The NIPD may oppose the application *ex officio*, either because of the existence of prior applications or on any of the grounds for absolute nullity. If there are no objections, the trademark will be granted. If there are objections from individuals or *ex officio* or both, the applicant will be given a period of 30 days to rebut them. Both parties have the right to produce evidence and the NIPD may, if it considers it necessary, also call for evidence. Once the objections have been processed, the NIPD will decide whether the trademark should be granted or refused. Applications for reconsideration may be filed and the decision may be appealed to the Executive Power as the superior authority, since the NIPD is a devolved, hierarchically subordinate body. Subsequently, the decision may be reviewed by the Administrative Tribunal, a specialized five-member quasi-judicial body. On the grounds permitted by the Law, third parties may also request the NIPD to cancel trademarks for absolute nullity (Article 4), or where they reproduce well-known marks and trade names, or where the registration was for purposes of unfair competition (Article 5, subparagraphs (6) and (7)).

The rights conferred by registration are specified in Articles 9 to 19 of Law No. 17.011. Registration is formative since the right in the trademark is acquired once it has been registered, which implies the presumption of lawful ownership (Article 9). Ownership is acquired exclusively with respect to the goods or services included in the application (Article 11). Moreover, the free circulation of products bearing the trademark, lawfully placed on the market by the trademark owner or with his authorization, may not be prevented (Article 12). Likewise, registration bestows the right to oppose the use or registration of any identical or similar trademark by third parties (Article 14). Ownership of a trademark may be inherited or assigned (Article 16). The use of a trademark is optional (Article 19). The Law also authorizes trademark owners to institute proceedings in the courts (civil and criminal) to prevent the continued use of their trademarks.

10. Please provide the length and terms of protection that the trademark law of Uruguay provides for a trademark.

Protection is for 10 years renewable indefinitely (Article 18).

D. GEOGRAPHICAL INDICATIONS

11. Please describe in detail how the laws of Uruguay provide for the recognition and protection of geographical indications required by Article 22.2 of the TRIPS Agreement, citing to the relevant provisions of law or regulation, and provide examples of geographical indications so protected.

Law 17.011 prohibits the registration as a trademark of appellations of origin, indications of source and any geographical name that is not sufficiently original and distinctive with regard to the goods or services to which it is applied or whose use is liable to create confusion regarding the origin, source, qualities or characteristics of the goods or services for which the mark is used (Article 4(4)). Moreover, Chapter XII of the Law provides for special protection for geographical indications, stipulating that indications of source are to be protected without need for registration (Article 74) and setting up a Register of Appellations of Origin (Article 76), while laying down the requirements for their protection (Article 77). Examples of the protection of geographical indications include the cancellation of the trademark FRANCIA CORTA requested for wines by a Uruguayan producer,

which is currently being applied for as an appellation of origin by grape and wine growers of the Italian region. The registration of FRONTIGNAC as a trademark, also applied for by a domestic producer, was similarly blocked, having been opposed by the regulatory body for French appellations of origin.

12. Please describe in detail the manner in which the higher level of protection required for wines and spirits under Article 23.2 of the TRIPS Agreement is implemented, citing to the relevant provisions of law or regulation, and provide examples of geographical indications for such products.

Article 23.2 of the TRIPS Agreement is covered by the protection afforded under the provisions mentioned in the reply to Question 11.

E. INDUSTRIAL DESIGNS

13. Please describe the procedure that must be followed to obtain protection for industrial designs, citing to the provisions of the law of Uruguay, and describe the nature of the protection provided.

Articles 86 to 92 of the new Uruguayan Law No. 17.164 on patents, utility models and industrial designs of 2 September 1999 provide for the protection of industrial designs. The provisions of the Law are supplemented by Articles 29 to 33 of its Regulatory Decree No. 11/000 of 13 January 2000.

The procedure for granting an application for an industrial design is as follows: filing of the application; its publication within 12 months of the date of filing or priority, or earlier at the request of the applicant; submission of comments by third parties within 30 days of publication; the NIPD may also submit comments at its discretion. The applicant is allowed 30 days in which to rebut any comments, whether submitted by third parties or *ex officio*, after which the resolution granting or refusing the application is finally issued (Articles 92 to 96 of the Law and Articles 29 to 32 of the Regulatory Decree).

Designs receive the protection accorded to patents, provided they are original creations of an ornamental nature incorporated in or applied to an industrial or craft product (Article 86). The patent right confers on its holder the right to prevent unauthorized persons from making, selling, offering for sale, using, importing or stocking for commercial purposes products incorporating the protected design (Article 88).

14. Please describe the procedure that must be followed to obtain protection for textile designs and cite to the relevant provisions of law or regulation.

The Patent Law makes no special provision for the protection of textiles. However, because of the time-limits, the early publication option and the optional nature of the substantive examination for compliance to be carried out by the NIPD the procedure laid down in the new Law makes it possible to obtain protection promptly, in accordance with Article 24.2 of the TRIPS Agreement.

At the same time, it should be borne in mind that, in accordance with Article 87 of Law No. 17.164, the protection conferred on industrial designs under the Law does not exclude or affect the protection that may be granted to the same design under other intellectual property protection regimes, which would include the parallel protection of the same design by copyright, provided it met the corresponding requirements, or by trademarks.

F. PATENTS

15. Please describe in detail the way in which the patent law of Uruguay implements Article 27 of the TRIPS Agreement, indicating any exceptions provided for, and including details regarding the protection for micro-organisms and non-biological and microbiological processes and plant varieties. Please cite to the relevant provisions of the law.

In accordance with Article 27.3(b) of the TRIPS Agreement, Article 13(b) of the Patent Law establishes that plants and animals, other than micro-organisms, and essentially biological processes for the production of plants or animals, other than non-biological and microbiological processes, are not to be considered inventions for the purposes of the Law. Under subparagraph (g) of Article 13, biological or genetic material existing in nature is likewise not considered to be an invention.

16. Please describe in detail the rights provided patent holders under the patent law of Uruguay and cite to the relevant provisions of law.

Under Article 34 of the Law, in accordance with Article 28 of the TRIPS Agreement, patents confer on their owners the right to prevent third parties not having the owner's consent from any of the following acts: (a) where the patent has been granted for a product: from making, offering for sale, selling or using the product, or importing or stocking it for any of these purposes; (b) where the patent has been granted for a process: from using the process and from any of the acts cited in subparagraph (a) in respect of products obtained by the said process.

17. Please describe in detail any provisions in the laws of Uruguay permitting unauthorized use of a patent, citing to the relevant provisions of law, and describe in detail the conditions under which such use can occur.

Articles 54 to 80 of the Patent Law (PL) authorize the granting of compulsory licences for various reasons: non-exploitation (Article 54), public interest (Articles 55 to 59), anti-competitive practices (Articles 60 to 63), unjustified refusal of a contractual licence (Articles 64 to 68), and dependent patents (Articles 69 and 70). The Law also contains a Chapter on general provisions and procedures (Articles 71 to 80) relating to compulsory licences. These articles lay down conditions for the granting of compulsory licences in accordance with Article 31 of the TRIPS Agreement.

Below, the corresponding provisions of the Patent Law are described in detail in the order of the paragraphs of Article 31 of the TRIPS Agreement:

- (a) The circumstances and requirements for the granting of licences for non-exploitation, reasons of public interest, anti-competitive practices, unjustified refusal of a contractual licence, and dependent patents are defined in Articles 54, 55, 60 and 61, 64, and 69 and 70, respectively.
- (b) Article 71 of the Patent Law lays down the requirements that persons wishing to obtain a compulsory licence must meet. Thus, they must have: requested a contractual licence from the owner of the patent and been unable to obtain it on fair commercial terms customary in Uruguay, within 90 days following the request. Under the second paragraph of Article 71, this requirement may be waived in situations of national emergency, extreme urgency, or in cases of non-commercial public use and anti-competitive practices.
- (c) From the provisions of Article 77 of the Patent Law, subparagraphs (a) and (c), as well as from the provisions cited in (a) above and those relating to the various types of compulsory licences (for example, Article 58 concerning public interest) it clearly

follows that their scope and duration are limited to the purpose for which they were granted.

- (d) Article 73 (a) of the Patent Law clearly establishes that compulsory licences may not be exclusive.
- (e) According to Article 73(d) of the PL, a compulsory licence may not be assigned without that part of the enterprise or goodwill which exploits the subject-matter of the licence.
- (f) Article 56 of the PL establishes that in the case of compulsory licences for reasons of public interest, the supply will be exclusively to meet the needs of the domestic market.
- (g) Under Article 59 of the PL, uses granted under a compulsory licence may be withdrawn, subject to appropriate protection of the legitimate interests of the persons who have received the authorization, if the circumstances which gave rise to the authorization have ceased to exist and are unlikely to recur. The competent authorities are empowered to examine whether such circumstances still exist, on receiving a substantiated request.
- (h) Article 77(b) establishes that, in general, the licensor will be remunerated and that the amount of remuneration will be fixed according to the circumstances specific to each case, taking into account the economic value of the exploitation of the licensed invention, as well as other factors such as average royalties for the sector under commercial licensing agreements.
- (i) The resolutions granting compulsory licences are issued by the National Industrial Property Directorate (NIPD) or by the Executive Power, in the case of licences for reasons of public interest. Both resolutions may be reviewed, upon application for reconsideration or appeal to a higher administrative authority in the case of the NIPD, an agency subordinate to the Executive Power. After that, under the Constitution and special laws, any final State resolution may be set aside by the Administrative Tribunal, a specialized five-member quasi-judicial body.
- (j) According to Article 74 of the PL, if the parties are unable to agree on the appropriate remuneration or the other conditions for the granting of a compulsory licence, an arbitral tribunal shall be appointed to decide the matter. Its decision will be adopted by a resolution of the NIPD (Article 75) granting the licence. Consequently, as the fixing of the remuneration forms part of the NIPD decision granting the licence, it can be reviewed in the same way as the latter, i.e. by recourse to the appropriate administrative remedies and then by an action to set aside before the Administrative Tribunal, as described in the preceding paragraph.
- (k) The second paragraph of Article 71 states that in the case of compulsory licences for anti-competitive practices (Articles 60 to 63 of the PL), the interested party, the potential user, may disregard the requirements imposed by the first paragraph in other cases.
 - (i) According to Article 60 of the PL, a compulsory licence may be granted for anti-competitive practices if the competent authority, following administrative or judicial procedures that confer on the patent owner the right to a fair hearing and other guarantees, has previously determined that the

owner has been involved in practices deemed anti-competitive or has abused the rights conferred by the patent or a dominant market position.

- (ii) Although the PL does not specifically provide for the correction of anti-competitive practices as a factor to be taken into account in fixing the amount of remuneration, inasmuch as the Law grants the competent authorities powers to determine that amount and to refuse to withdraw the authorization if the circumstances which gave rise to it are likely to recur, it is clear from the provisions as a whole that the authorities must take this factor into account. Thus, for example, Article 62 of the PL states that if the owner of the patent continues the acts or practices that led to the determination of anti-competitive practices or abuse of the rights conferred by the patent, the right to the patent may be cancelled, either *ex officio* or at the request of an interested party, subject to a prescribed period of notice.
- (1) As already mentioned, Articles 69 and 70 of the PL deal with the subject of “dependent patents”. According to Article 69, if a patented invention or utility model cannot be exploited without infringing an earlier patent, the owner or a licensee may request the grant of a compulsory licence in respect of the other patent, insofar as it is necessary to work the patent and avoid infringement. Article 70 lays down the conditions for the granting of this type of compulsory licence, namely: the invention claimed in the second patent must involve an important technical advance of considerable economic significance in relation to the invention claimed in the first patent (subparagraph (a)); the owner of the first patent must be entitled to obtain a cross licence on reasonable terms to use the invention claimed in the second patent (subparagraph (b)); and assignment of the authorized use of the first patent must include use of the second patent (subparagraph (c)).

The other requirements of Article 31 of the TRIPS Agreement concerning notification of the patent holder as soon as reasonably practical when compulsory licences are granted in situations of national emergency (subparagraph (b)); the informing of the right holder in cases of public non-commercial use; the restriction of compulsory licences for semi-conductor technology to cases of public non-commercial use or the remedying of anti-competitive practices (subparagraph (c)); and, in part, use predominantly for the supply of the domestic market are not specifically provided for in the PL. However, they are mandatory by application of the general principles laid down in the legislation, such as those requiring that the patent holder be notified or informed, or because the provisions of the TRIPS Agreement itself so require, since, as has repeatedly been pointed out, these provisions have been incorporated into the national legislation and form part of domestic law, for example Law No. 16.671 of 13 December 1994 on semi-conductor technology.

18. What term of protection does the patent law of Uruguay provide for patents? Please describe any provisions for extension of the term of protection and cite to the relevant provisions of the law.

In accordance with Article 33 of the TRIPS Agreement, Article 21 of the Law states that the term of protection for patents for inventions shall be 20 years as from the application filing date, while making no provision for extensions.

G. LAYOUT-DESIGNS (TOPOGRAPHIES) OF INTEGRATED CIRCUITS

19. Please describe in detail the protection for layout-designs of integrated circuits provided under the laws of Uruguay, including the term of protection, and cite to the relevant provisions of law.

As repeatedly noted, Uruguay's ratification of the TRIPS Agreement incorporated its provisions, and in particular Articles 35 to 38 concerning integrated circuits, into the domestic law.

In its turn, the reference in Article 35 of the TRIPS Agreement to Articles 2 through 7 (other than paragraph 3 of Article 6), Article 12 and paragraph 3 of Article 16 of the Treaty on Intellectual Property in Respect of Integrated Circuits incorporates these provisions into domestic law also, making them mandatory. Therefore, without prejudice to the possibility of their direct individual application, they constitute a positive source of integration and interpretation additional to the specific rules of the legislation on patents, industrial designs, copyright and unfair competition adopted to protect layout-designs of integrated circuits, as the case may be, or prevent acts of unfair competition that might affect their creators.

In accordance with the above and Article 4 of the Integrated Circuits Treaty, layout-designs that meet the corresponding requirements for the acquisition of each type of right may acquire protection through patents, industrial designs or copyright, or through the rules on unfair competition.

The protection provided for patents and industrial designs and for copyright, together with the general provisions of civil and procedural law, by application of the general principles or as a result of the rules on unfair competition, confer on the right holder and the creator of the layout-design civil remedies and provisional measures for protecting their right.

H. PROTECTION OF UNDISCLOSED INFORMATION

20. Please describe in detail how the laws of Uruguay provide for the protection of undisclosed information as required by Article 39.2 of the TRIPS Agreement and provide citations to the relevant provisions of law.

Like the other provisions of the TRIPS Agreement, the provisions of the Paris Convention (Stockholm Act of 14 July 1967), and in particular those of its Article 10*bis* on unfair competition, have been incorporated into Uruguay's domestic law, having been ratified by Decree-Law No. 14.910 of 10 July 1979. Consequently, by application of these provisions and, moreover, the general rules and principles of civil law, persons who have lawfully within their control information that fulfils the requirements of Article 39.2 of the TRIPS Agreement may prevent it from being disclosed to, acquired by, or used by others in a manner contrary to honest commercial practices.

21. Please describe in detail the manner in which protection is provided test data regarding pharmaceutical and agricultural chemical products submitted to the government in order to obtain marketing approval in Uruguay and cite to the relevant provisions of law.

With regard to undisclosed submitted to the competent authority as a condition of approval of the marketing of pharmaceutical or agricultural chemical products, provided they meet the requirements of Article 39.3 of the TRIPS Agreement, they will be protected against unfair commercial use. Moreover, Article 197 of Law No. 17.296 stipulates that officials of the Ministry of Livestock, Agriculture and Fisheries who obtain information in the course of their inspection activities must keep that information secret.

Likewise, they must preserve the confidentiality of any administrative or judicial proceedings of which they have knowledge.

At the same time, Article 6 of Executive Decree No. 324/999 of 12 October 1999 on the approval of the marketing of pharmaceutical products states that the applicant must declare the undisclosed nature of information provided for the purpose of obtaining authorization.

22. Are other applicants for marketing approval for their own versions of a previously approved pharmaceutical or agricultural chemical products permitted to rely on data submitted by the earlier applicant? If so, how long a period of exclusivity is given the earlier applicant before such reliance becomes possible.

Apart from the above-mentioned protection against unfair use under Article 39.3 of the TRIPS Agreement, Uruguay has no provisions for non-use by the marketing approval authority of test data to which it has previously had access for the purpose of approving a version of the same product. However, the authority and its officials are obliged to keep secret any information submitted for marketing approval purposes.

I. ENFORCEMENT

23. Please describe in detail the manner in which the laws of Uruguay provide for effective action against infringement of intellectual property rights as required by Article 41.1 of the TRIPS Agreement.

Copyright and related rights

The Uruguayan Copyright Law (No. 9.739 of 17 December 1937) and the Codes of Civil and Criminal Procedure contain provisions that have been duly applied to ensure the enforcement of copyright.

These include procedural rules permitting judicial examinations, without the knowledge of the opposing party or alleged infringer, for the purpose of establishing breaches of the law; in addition, there are provisions relating to the seizure of infringing copies and equipment and laying down civil and criminal penalties.

Industrial property

In relation to Article 41.1 of the TRIPS Agreement, there are expeditious administrative and judicial remedies to deter any infringement:

From the administrative standpoint, both Trademark Law No. 17.011 and its Regulatory Decree No. 34/99 and Patent Law No. 17.164 and its Regulatory Decree No. 11/00 provide for special administrative procedures based on the latest standards.

From the judicial standpoint, Laws Nos. 17.011 and 17.164, Articles 81 to 85 and 106 and 107, respectively, establish offences and penalties for infringers of industrial property rights, namely, trademarks and appellations of origin, in the first instance, and patents, utility models and industrial designs, in the second.

Likewise, Articles 87 and 88 of Law No. 17.011 and 99 to 105 of Law No. 17.164 provide for civil proceedings for infringements of the trademark and patent regulations.

All these procedures, both administrative and judicial, whether civil or criminal, are based on the constitutional principle of due process. The administrative procedures are laid down in special laws and decrees such as Decree No. 500/91, which applies to the Uruguayan public service in general. Civil proceedings are governed by the General Code of Procedure and criminal proceedings by the Code of Criminal Procedure.

24. Article 43.1 of the TRIPS Agreement requires that judges be authorized to order production of evidence necessary to substantiate a party's claims where that party has been unable to obtain such evidence from the opposing party. Please describe how the laws or regulations of Uruguay provide this authorization, citing to the relevant provisions of law or regulation.

Copyright and related rights

The substance of this provision is not expressly included in the copyright legislation.

This judicial authority may nevertheless be regarded as covered by the general and particular rules of procedure.

Thus, Article 168 of the General Code of Procedure (Law No. 15.982 of 18 October 1988) on documents within the control of the opposing party states: "A party wishing to make use of a document which it declares to be within the control of the opposing party may request the court to order the latter to produce it within the period it shall determine.

If other evidence clearly shows the probable existence and content of the document, refusal to produce it shall be regarded as acknowledgement of that content."

In this respect, reference may also be made to Article 189 of the Code, entitled "Cooperation in the taking of evidence", paragraph 3 of which states: "If one of the parties is required to cooperate and unjustifiably refuses to do so, the court may order its cooperation. If, despite that, it should continue in its recalcitrance, the court may order that the formalities be waived and the refusal to cooperate interpreted in the evidence as confirmation of the accuracy of the statements of the opposing party with regard to the fact it is desired to prove, in the absence of proof to the contrary."

At the same time, the wording of Article 43.1 suggests that this is a self-enforcing provision since it stipulates that: "The judicial authorities shall have the authority ... to order ...".

Industrial property

In relation to Article 43.1 of the TRIPS Agreement, Article 168 of the GCP allows the plaintiff to request that the opposing party be ordered to produce documentation within his control which the plaintiff wishes to use. Refusal may be regarded as acknowledgement of content.

25. Please describe in detail the all of the civil remedies that are available to right holders under the laws of Uruguay, citing to the relevant provisions of law or regulation.

Copyright and related rights

It is first necessary to cite the above-mentioned General Code of Procedure. Articles 306 *et seq.* provide for a series of "preparatory measures" applicable to any proceedings. Thus:

"Any proceedings may, at the initiative of a party, include a preliminary phase for the purpose of:

- (1) determining or completing the active or passive legitimation of the parties to the future proceedings;
- (2) expediting the taking of evidence which might be lost if action were postponed to a later stage;
- (3) serving notices to establish default and obtaining elements needed for the proceedings such as documents, accounts and the like;
- (4) ordering precautionary measures or the provision of security in connection with the subsequent proceedings.

Articles 311 *et seq.* also establish precautionary measures.”

Secondly, Article 47 of Copyright Law No. 9.739 of 17 December 1937, as amended by Article 328 of Law No. 16.170 of 27 December 1987, stipulates that:

“The unlawfully reproduced copies and any materials used for reproduction, communication or public performance shall be seized.

As a preparatory measure, the interested party may request their attachment and, where good cause can be shown, apply to the competent court for exemption from counter-security.

The judgement shall, in all cases, order the destruction or disablement of the copies and materials seized, if these are able to be used, to the extent necessary to prevent unlawful exploitation.

Copies acquired by third parties in good faith for their personal use shall not be destroyed.”

With regard to civil liability, Article 51 of Law No. 9.739 provides for civil proceedings for damages and for the imposition on infringers of a civil penalty consisting of the profits or income improperly received. Thus, in accordance with the Law in force, as reflected in Uruguayan legal theory and precedents, infringers are liable not only for damages (consequential damages and loss of income) but also for all profits or income improperly received as a result of the unlawful exploitation of the work.

Industrial property

The judicial procedures concerning enforcement are laid down in Articles 87 and 88 of Trademark Law No. 17.011, which authorize actions for damages and the prohibition of the use of infringing marks, and Articles 99 to 105 of Patent Law No. 17.164, which authorize actions against anyone performing acts in violation of the rights deriving therefrom. In these cases, the interested parties may make use of the ordinary proceedings laid down in Articles 337 *et seq.* of the GCP or the precautionary proceedings laid down in Articles 311 *et seq.* of the same Code. Those concerned are personally notified of all complaints and receive a copy of the document. Article 44 of the Code permits the parties to be represented by their attorney, except at the preliminary hearing when they must appear in person accompanied by a lawyer. The court costs correspond to the fees and charges laid down by the budgetary laws in force and are relatively low. Each party must attach to the complaint or plea the evidence on which its arguments are based (Articles 117 and 131 GCP) and this evidence is collected by the Court: the documentary evidence is combined with the notification of the other party, the procedural documents are processed and witnesses are questioned (Articles 341 and 343 GCP). The two parties then plead on the basis of the evidence presented (Article 343 GCP) and, finally, the judge delivers a duly reasoned judgement (Article 343 GCP), which may be appealed by

either of the parties (Articles 248 to 261), in which case the file is transmitted to a three-member higher court or tribunal (Article 344 GCP).

26. Please describe in detail the provisional procedures and remedies available to right holders under the laws of Uruguay, citing to the relevant provisions of law and regulation, and indicate any condition under which a right holder may avail itself of those procedures and remedies.

Article 103 of Patent Law No. 17.164 provides for the adoption of provisional or precautionary measures in accordance with the GCP. Article 317 of the GCP deals with provisional measures, laying down the same procedure as for precautionary measures (Articles 311 to 316). Where the preservation of evidence is concerned, in addition to these articles, Article 309.6 on preliminary measures also applies. Article 315 of the GCP provides for measures of this kind to be ordered without the knowledge or intervention of the other party. Articles 314.2 and 314.3 of the GCP require the production of *prima facie* evidence and security and the adoption of the measure is decided as soon as the evidence has been examined. Article 315 of the GCP provides for notification of the measure immediately upon execution and both the person affected by the measure and the applicant may appeal the decision. Article 311.2 of the GCP provides for precautionary measures to lapse automatically if a complaint is not lodged within 30 days and for the applicant to be ordered to pay all the costs of the proceedings and any damages.

J. SPECIAL REQUIREMENTS RELATED TO BORDER MEASURES

27. Please describe in detail the procedures under the laws of Uruguay that provide for border enforcement at least for trademark counterfeiting and copyright piracy, identifying the competent authority and citing to the relevant provisions of law or regulation.

Copyright and related rights

Under the Uruguayan legal system, the party affected may request the courts to apply precautionary measures where there is a possibility of counterfeit or unlawfully reproduced goods entering the country.

As for the present Copyright Law, it does not contain any express provisions. The draft law, approved with amendments in the Chamber of Representatives and currently being considered in the Culture Committee of the Chamber of Senators, incorporates the following Article 137:

“Holders of intellectual property rights who have valid grounds for suspecting that attempts or preparations are being made to import into the national territory goods which, in accordance with the terms of the applicable legislation, have been manufactured, distributed or imported, or are intended for distribution, without the authorization of the holder of the intellectual property right may request the competent customs or judicial authorities to order special control measures in respect of those goods, their preventive attachment or the precautionary suspension of the corresponding customs procedure. Evidence justifying the suspicions must be produced.

If the request is made to the National Directorate of Customs, the latter, having ordered the precautionary measures requested, shall promptly notify the importer and the applicant. If within 10 working days of notification of the right holder or his representative, no evidence of initiation of the corresponding civil or criminal proceedings has been received, the preventive measures shall be revoked and the goods released, without prejudice to any liabilities that may have been incurred by an applicant who has knowingly lodged an unfounded complaint.”

Industrial property

The release of goods may be suspended by the judicial (customs court) or administrative (customs collectors) authorities upon receipt of a substantiated complaint that goods are about to be imported in infringement of intellectual property rights. Once it is shown that the offence is not one of the three for which Law No. 13.318 on customs disputes provides, namely, smuggling, discrepancies and fraud, the customs court must render account to the Criminal Court.

28. Please indicate if border enforcement is available to owners of other forms of intellectual property and, if so, please describe the procedures and remedies available in relation to each form of intellectual property, citing the relevant provisions of law.

Copyright and related rights

With respect to copyright, please refer to the reply to Question 27.

Industrial property

The provisions mentioned in the reply to the Question 27 are applicable to the owners of other forms of intellectual property, such as patents, utility models, etc.

29. Article 58 of the TRIPS Agreement specifies procedures to be followed where the competent authorities can act *ex officio*. Please explain whether the competent authorities in Uruguay are empowered to act *ex officio* and, if so, please identify the intellectual property areas subject to *ex officio* action.

Copyright and related rights

Without prejudice to the above, in the field of copyright the National Directorate of Customs has acted *ex officio* in certain situations involving goods presumed to be unlawful or suspicious.

Industrial property

There is no express provision in the Uruguayan legislation for the *ex officio* action mentioned in Article 58 of the TRIPS Agreement. Nevertheless, customs administrative proceedings have been initiated through the Foreign Ministry at the request of the Embassy of another Member State.

K. CRIMINAL PROCEDURES

30. Please describe in detail how the laws of Uruguay implement Article 61 of the TRIPS Agreement that requires Members to have criminal procedures and penalties, including imprisonment and/or monetary fines sufficient to act as a deterrent, at least for cases of wilful trademark counterfeiting and copyright infringement on a commercial scale. Please cite to the relevant provisions of law and regulation.

Copyright and related rights

In the criminal law there are two provisions relating to copyright and related rights.

Firstly, Article 46 of Law No. 9.739, the Copyright Law, as amended by Article 23 of Law No. 15.913 of 17 November 1987, stipulates that: "Whoever publishes, sells, reproduces or causes to be reproduced by any means, in whole or in part, an unpublished or published work without the written authorization of its author or his successor in title or its purchaser, in whatever capacity, or

attributes it to a different author, thereby contravening the provisions of this Law, shall be liable to a term of from three months' to three years' imprisonment.”

Secondly, Law No. 15.289 of 14 July 1982 introduced a new criminal offence with a view to protecting producers of phonograms and/or videograms from unauthorized reproductions. According to Article 1, “Anyone reproducing a phonogram or videogram for gain and without the written authorization of its producer, and anyone distributing to the public or stocking for that purpose the reproductions thus obtained, shall be liable to the penalty laid down in Article 46 of Law No. 9.739 of 17 December 1937. The same penalty shall be applicable to anyone fixing the live performance of a literary or artistic work by whatever means, clearly for the purpose indicated in the previous sentence and without the written authorization of the author and the performer, as well as to anyone distributing to the public or stocking for that purpose the versions thus obtained.”

At the same time, it should be pointed out that a draft law establishing a new regulatory framework for copyright has been approved by the Chamber of Representatives and is currently being considered in the Chamber of Senators.

Article 146 of the draft law establishes a new criminal offence characterized as follows: “Whoever, without the authorization of their author or respective owner protected by this Law, introduces works, performances, phonograms or broadcasts into a data storage system for the purpose of reproducing or distributing them shall be liable to imprisonment for three to 24 months.”

Article 47 of Copyright Law No. 9.739 of 17 December 1937, as amended by Article 328 of Law No. 16.170 of 27 December 1987, stipulates that:

“The unlawfully reproduced copies and any materials used for reproduction, communication or public performance shall be seized.

As a preparatory measure, the interested party may request their attachment and, where good cause can be shown, apply to the competent court for exemption from counter-security.

In any event, the judgement shall order the destruction or rendering useless of the copies and materials seized if they are capable of being used, to the extent necessary to prevent unlawful exploitation.

Copies acquired by third parties in good faith for their personal use shall not be destroyed.”

Industrial property

Article 61 of the TRIPS Agreement is implemented as follows:

Articles 81 to 83 of Trademark Law No. 17.011 establish offences and penalties relating to trademarks. There is also provision for the forfeiture and destruction of goods (Article 84) and the protection is extended to appellations of origin (Article 85).

Articles 106 and 107 of Patent Law No. 17.164 establish offences and penalties relating to patents, characterizing them as follows:

Article 106 provides for a term of six months' to three years' imprisonment for anyone who infringes any of the rights protected by patents. It also provides for the forfeiture of the infringing products and the implements used in making them.

Article 107 increases the term of imprisonment to 15 months to four years in the following aggravating circumstances: (a) where the infringer was an employee of the patent owner or a licensee and (b) where he obtained from the latter knowledge of the special methods of making the patented product.

31. Article 61 also requires that remedies in appropriate cases include the seizure, forfeiture and destruction of infringing goods and any materials and implements the predominant use of which has been the commission of the offence. Please describe the provisions in the laws of Uruguay that provide for such remedies, and describe the circumstances in which those remedies would be imposed, citing to the relevant provisions of law or regulation.

Copyright and related rights

The reply to this question is contained in previous replies.

Industrial property

As has just been shown, the new laws on trademarks and other distinctive signs (Law No. 17.011 of 25 September 1998) and on patents, utility models and industrial designs (Law No. 17.164 of 2 September 1999) contain many important provisions concerning the enforcement of the corresponding intellectual property rights which supplement and support the general measures derived from ordinary civil and procedural law.

The criminal provisions relating to patents in Articles 106 and 107 of the PL are as follows:

Article 106 provides for a term of six months' to three years' imprisonment for anyone who infringes any of the rights protected by patents. It also provides for the forfeiture of the infringing products and the implements used in making them.

Article 107 increases the term of imprisonment to 15 months to four years in the following aggravating circumstances: (a) where the infringer was an employee of the patent owner or a licensee and (b) where he obtained from the latter knowledge of the special methods of making the patented product.

The replies to Questions 23 to 25 are reproduced in the order of Articles 41 to 50 of Part III (Enforcement of Intellectual Property Rights), Sections 1, 2 and 3 of the TRIPS Agreement.

32. Article 61 also indicates that Members may provide for criminal procedures and penalties in cases of wilful infringement of other forms of intellectual property. Please describe any provisions of the laws of Uruguay that provide for such procedures and remedies, citing to the relevant provisions of law or regulation.

Copyright and related rights

The legal provisions are those referred to above.

L. STATISTICAL INFORMATION

33. Please provide statistical information related to civil copyright, trademark, geographical indication, industrial design, patent, integrated circuit layout-design, and trade secret enforcement for 2000, including the number of cases filed; injunctions issued; infringing products seized; infringing equipment seized; cases resolved (including settlement); and the amount of damages awarded.

Copyright and related rights

No such information is available. The Copyright Council will try to implement mechanisms for obtaining this information.

34. Please provide statistical information related to criminal enforcement in the area of copyright piracy and trademark infringement for 2000, including the number of raids, prosecutions, convictions, and the amount of fines and/or jail terms (including whether the fines were paid and whether the jail term was actually served or was suspended) and any other information establishing that the criminal system operates effectively to deter copyright piracy and trademark counterfeiting.

Copyright and related rights

It is known that in the field of copyright there have been proceedings for phonogram, videogram and computer program piracy. There have also been convictions leading to prison sentences. The statistical information requested is not available. As in the previous case, efforts to implement mechanisms for obtaining this information will be made through the Copyright Council.

V. REPLIES TO THE QUESTIONS POSED BY JAPAN

A. COPYRIGHT AND RELATED RIGHTS

1. Please explain exceptions or exemptions of the National Treatment and Most-Favoured-Nation Treatment under the Copyright and Neighbouring Rights Law, if any, as permitted in Articles 3 and 4 of the TRIPS Agreement.

National treatment is provided for in Uruguay's Copyright Law No. 9.739 of 17 December 1937. Specifically, according to Article 4, "The legal protection of this right shall be accorded in all cases and to the same extent, whatever the nature or origin of the work or the nationality of its author and without distinction as to school, denomination or philosophical, political or economic tendency."

With regard to "most-favoured-nation treatment", no agreements have been approved subsequent to the entry into force of the TRIPS Agreement that involve its application.

B. TRADEMARKS

2. Regarding "well-known trademark", please explain how legislation of your country implements Article 16.2 and 16.3 of the TRIPS Agreement, to which Article 6bis of the Paris Convention shall apply, *mutatis mutandis*. Please cite the relevant provisions of your country's law.

The Uruguayan trademark legislation (Law No. 17.011 of 25 September 1998) protects well-known trademarks by providing for the nullity of signs or words constituting the total or partial reproduction, imitation or translation of a well-known mark.

C. PROTECTION OF UNDISCLOSED INFORMATION

3. Please explain how legislation of your country provides for the protection of "undisclosed Information" as required by Article 39.1 and 39.2 of the TRIPS Agreement. Please explain in detail and please cite the relevant provisions of your country's law.

Like the other provisions of the TRIPS Agreement, the provisions of the Paris Convention (Stockholm Act of 14 July 1967), and in particular those of its Article 10*bis* on unfair competition, have been incorporated into Uruguay's domestic law, having been ratified by Decree-Law No. 14.910 of 10 July 1979. Consequently, by application of these provisions and, moreover, the general rules and principles of civil law, persons who have lawfully within their control information that fulfils the requirements of Article 39.2 of the TRIPS Agreement may prevent it from being disclosed to, acquired by, or used by others in a manner contrary to honest commercial practices.

4. If your legislation ensures that undisclosed test or other data submitted by an applicant to the responsible State agency in the procedure for market authorization of a pharmaceutical or an agricultural chemical product is protected against disclosure and against unfair commercial use by a competitor, for example by prohibiting a second applicant for a similar product from relying on original data of the first applicant, when applying subsequently for market authorization for a similar product, please explain it in detail. Does legislation of your country provide for exceptions to this? Does legislation of your country set a specific term of protection by the responsible State agency for undisclosed test or other data of the first applicant? If yes, please explain such specific term in detail, citing the relevant provisions of law.

With regard to undisclosed test or other data submitted to the competent authority as a condition of approval of the marketing of pharmaceutical or of agricultural chemical products, provided they meet the requirements of Article 39.3 of the TRIPS Agreement, they will be protected against unfair commercial use. Moreover, Article 197 of Law No. 17.296 stipulates that officials of the Ministry of Livestock, Agriculture and Fisheries who obtain information in the course of their inspection activities must keep that information secret and preserve the confidentiality of any administrative or judicial proceedings of which they have knowledge.

At the same time, Article 6 of Executive Decree No. 324/999 of 12 October 1999 on the approval of the marketing of pharmaceutical products states that the applicant must declare the undisclosed nature of information provided for the purpose of obtaining authorization.

D. ENFORCEMENT

5. Please indicate the remedies which the judicial authorities order regarding each of the intellectual property rights provided in the TRIPS Agreement, including injunctions, damages, expenses, destruction or disposal of infringing goods, materials or implements for their production. Please explain the criteria and the way of calculation to decide the amount of the damages which judicial authorities order to the infringer to pay the right holder.

Copyright and related rights

On the basis of the Uruguayan legislation in force, the judicial authorities have at their disposal remedies for dealing with breaches of the law, both civil and criminal. These normally take the form of preparatory or preliminary measures.

Article 47 of Copyright Law No. 9.739 of 17 December 1937, as amended by Article 328 of Law No. 16.170 of 27 December 1987, stipulates that:

“The unlawfully reproduced copies and any materials used for reproduction, communication or public performance shall be seized.

As a preparatory measure, the interested party may request their attachment and, where good cause can be shown, apply to the competent court for exemption from counter-security.

The judgement shall, in all cases, order the destruction or disablement of the copies and materials seized, if these are able to be used, to the extent necessary to prevent unlawful exploitation.

Copies acquired by third parties in good faith for their personal use shall not be destroyed.”

Article 51 of Law No. 9.739 provides for civil proceedings for damages and for the imposition on infringers of a civil penalty consisting of the profits or income improperly received. Thus, in accordance with the Law in force, as reflected in Uruguayan legal theory and precedents, infringers are liable not only for damages (consequential damages and loss of income) but also for all profits or income improperly received as a result of the unlawful exploitation of the work.

Industrial property

In Uruguay, expeditious deterrent action, both administrative and judicial, can be taken against any act of infringement.

All these proceedings, both administrative and judicial, whether criminal or civil, are based on the constitutional principle of due process.

The administrative procedure is laid down in special laws and decrees, as well as in General Decree No. 500/91, which covers the whole of the Uruguayan public service.

Provisional measures may be ordered under administrative procedures, since Decree No. 500/91 on administrative procedures authorizes the application of the GCP, wherever relevant.

Civil proceedings are governed by the General Code of Procedure (GCP) and criminal proceedings by the Code of Criminal Procedure (CCP).

Administrative decisions are taken by the competent administrative authority through administrative acts, which are always reasoned and in writing, within a file that always takes written form.

As far as evidence is concerned, all the parties involved have an opportunity to produce evidence, to verify the evidence produced by the other party and to submit arguments relating to the evidence produced. The time-limits for producing evidence, the manner in which the evidence is presented and the form it takes are all regulated, as are the time-limits for processing it and for submitting arguments.

Administrative decisions can be reviewed by a specialized five-member quasi-judicial body (Administrative Tribunal).

Judicial decisions (judgments), also in writing and duly reasoned, are taken by the judges who make up the judiciary. These decisions must be notified to the parties personally or, if this is physically impossible, by means which ensure that the interested party is aware of them.

Judicial decisions made by judges in the courts of first instance, whether civil (civil or district judges depending on the jurisdiction) or criminal, can always be reviewed by the specialized appeal courts. In these cases, the judgements, depending on the jurisdiction, may be set aside by the five-member Supreme Court of Justice, the highest judicial authority.

The Trademark and Patent Laws empower the ordinary courts to order infringers of industrial property rights to pay damages where there is fault or fraud. The payment of costs and charges may be ordered only in cases of bad faith or culpable negligence.

The Civil Code provides, in general, for liability and the payment of damages in cases of fault or fraud.

6. Please explain the kind and amounts of criminal penalties including implement and fines regarding intellectual property rights, citing the relevant provisions of your country's law. In particular, are the crimes persecuted only when the injured party has made a formal complaint? Please explain whether penalties are consistent with Article 61 of the TRIPS Agreement, which requires provisions for a sufficient deterrent, consistently with the level of penalties applied for crimes of a corresponding gravity.

Copyright and related rights

In the criminal law there are two provisions relating to copyright and related rights.

Firstly, Article 46 of Law No. 9.739, the Copyright Law, as amended by Article 23 of Law No. 15.913 of 17 November 1987, stipulates that: "Whoever publishes, sells, reproduces or causes to be reproduced by any means, in whole or in part, an unpublished or published work without the written authorization of its author or his successor in title or its purchaser, in whatever capacity, or attributes it to a different author, thereby contravening the provisions of this Law, shall be liable to a term of from three months' to three years' imprisonment." Secondly, Law No. 15.289 of 14 July 1982 introduced a new criminal offence with a view to protecting producers of phonograms and/or videograms from unauthorized reproductions. According to Article 1, "Anyone reproducing a phonogram or videogram for gain and without the written authorization of its producer, and anyone distributing to the public or stocking for that purpose the reproductions thus obtained, shall be liable to the penalty laid down in Article 46 of Law No. 9.739 of 17 December 1937. The same penalty shall be applicable to anyone fixing the live performance of a literary or artistic work by whatever means, clearly for the purpose indicated in the previous sentence and without the written authorization of the author and the performer, as well as to anyone distributing to the public or stocking for that purpose the versions thus obtained."

Complaints for infringement of copyright are prosecuted *ex officio* or through public right of action.

At the same time, it should be pointed out that a draft law establishing a new regulatory framework for copyright has been approved by the Chamber of Representatives and is currently being considered in the Chamber of Senators.

Article 146 of the draft law establishes a new criminal offence characterized as follows: "Whoever, without the authorization of their author or respective owner protected by this Law, introduces works, performances, phonograms or broadcasts into a data storage system for the purpose of reproducing or distributing them shall be liable to imprisonment for three to 24 months."

Industrial property

In accordance with Article 61 of the TRIPS Agreement, Trademark Law No. 17.011 establish offences and penalties relating to trademarks, as well as providing for the forfeiture and destruction of goods and extending the protection to appellations of origin.

It also provides for the infringing marks and the implements used for making them to be destroyed or rendered unusable and for the infringing goods to be seized and destroyed, unless they can be awarded to public or private charitable institutions.

The Patent Law specifies a term of six months' to three years' imprisonment for anyone who infringes any of the rights protected by patents. It also provides for the forfeiture of the infringing products and the implements used in making them.

Under the same Law the term of imprisonment may be increased to 15 months to four years where the following aggravating circumstances apply: (a) where the infringer was an employee of the patent owner or a licensee and (b) where he obtained from the latter knowledge of the special methods of making the patented product.

Moreover, infringing articles and the implements used in making them may be seized and their fate decided in consultation with the NIPD.

7. Please indicate titles of laws and regulations and their provisions in which the suspension of the release of counterfeit trademark or pirated copyright goods is prescribed, as stipulated in Article 51 of the TRIPS Agreement.

Copyright and related rights

Under the Uruguayan legal system, the party affected may request the courts to apply precautionary measures where there is a possibility of counterfeit or unlawfully reproduced goods entering the country.

The National Directorate of Customs has acted *ex officio* in several proceedings relating to unlawfully reproduced goods.

As for the present Copyright Law, it does not contain any express provisions. The draft law, approved with amendments in the Chamber of Representatives and currently being considered in the Culture Committee of the Chamber of Senators, incorporates the following Article 137:

“Holders of intellectual property rights who have valid grounds for suspecting that attempts or preparations are being made to import into the national territory goods which, in accordance with the terms of the applicable legislation, have been manufactured, distributed or imported, or are intended for distribution, without the authorization of the holder of the intellectual property right may request the competent customs or judicial authorities to order special control measures in respect of those goods, their preventive attachment or the precautionary suspension of the corresponding customs procedure. Evidence justifying the suspicions must be produced.

If the request is made to the National Directorate of Customs, the latter, having ordered the precautionary measures requested, shall promptly notify the importer and the applicant. If within 10 working days of notification of the right holder or his representative, no evidence of initiation of the corresponding civil or criminal proceedings has been received, the preventive measures shall be revoked and the goods released, without prejudice to any liabilities that may have been incurred by an applicant who has knowingly lodged an unfounded complaint.”

Industrial property

The release of goods may be suspended by the judicial (customs court) or administrative (customs collectors) authorities upon receipt of a substantiated complaint that goods are about to be imported in infringement of intellectual property rights. Once it is shown that the offence is not one of the three for which Law No. 13.318 on customs disputes provides, namely, smuggling, difference and fraud, the customs court must render account to the Criminal Court.

In accordance with Article 61 of the TRIPS Agreement, Trademark Law No. 17.011 establishes offences and penalties relating to trademarks (Articles 81 to 83), as well as providing for the forfeiture and destruction of goods (Article 84) and extending the protection to appellations of origin (Article 85).

The criminal provisions of the Patent Law specify a term of six months' to three years' imprisonment for anyone who infringes any of the rights protected by patents. It also provides for the forfeiture of the infringing products and the implements used in making them.

This term of imprisonment may be increased to 15 months to four years where the following aggravating circumstances apply: (a) where the infringer was an employee of the patent owner or a licensee and (b) where he obtained from the latter knowledge of the special methods of making the patented product.

VI. REPLIES TO THE QUESTIONS POSED BY SWITZERLAND

A. PATENTS

Uruguayan patent law

Uruguay has a new law on patents, utility models and industrial designs, namely Law No. 17.164 approved on 2 September 1999, which entered into force on 18 January 2000 (hereinafter "PL").

With this law Uruguay completed the process of adapting its relevant legislation in order to fulfil its obligations under the TRIPS Agreement, having updated its patent law in accordance with modern legislative standards.

Moreover, by Law No. 16.671 of 17 December 1995 Uruguay ratified the TRIPS Agreement, incorporating its provisions into the Uruguayan national legislation to form part of domestic law.

In the field of enforcement, in addition to the specific provisions of the new Law, the modern rules of the General Code of Procedure establish expeditious and flexible procedures that permit the adoption of a broad range of provisional and precautionary measures, within a context of respect for the rights of the defence and equal treatment of the parties.

1. Does your legislation grant patent protection for inventions relating to products and processes in all fields of technology? Please indicate details regarding the protection for micro-organisms and non-biological and microbiological processes. Are there any exceptions? If so, please explain what these exceptions are and how they comply with Article 27 of the TRIPS Agreement. How are plant varieties protected in your law?

Article 27.1: Article 8 of the Law states that inventions of new products or processes which involve an inventive step and are capable of industrial application are patentable, i.e. this basic

provision includes all fields of technology without discrimination as to the place of invention, technological sector or origin of the patented products or processes.

In keeping with most modern legislation, Article 13 of the Patent Law, subparagraphs (a), (c), (d) and (e), specifies and lists the subject-matter that does not constitute a patentable invention because it fails to meet the requirements of patentability. Thus, the following are not considered inventions for the purposes of the Law: discoveries, scientific theories and mathematical methods (a); schemes, plans, rules for playing games, business, accounting, financial, educational, publicity, lottery or taxation principles or methods (c); literary or artistic works, or any other aesthetic creation, and scientific works (d); computer programs considered in isolation (e); and various methods of reproducing information (f).

Article 27.2: Article 14(b) of the Patent Law stipulates that inventions contrary to public order, morality, public health, the national food supply, security or the environment shall not be patentable.

Article 27.3(a): Article 14(a) of the Patent Law stipulates that diagnostic, therapeutic or surgical methods for the treatment of humans or animals shall not be patentable.

Article 27.3(b): Article 13(b) stipulates that plants and animals, other than micro-organisms, and essentially biological processes for the production of plants or animals, other than non-biological and microbiological processes, are not considered to be inventions.

According to Article 13(g) of the Patent Law, biological or genetic material existing in nature is not considered to be an invention.

Plant varieties are protected by special legislation based on the standards of the UPOV Convention, to which Uruguay is party. The 1978 version of this Convention was approved by Law No. 16.580 of 21 September 1994. Moreover, Law No. 16.811 of 21 February 1997 contains the national legislation on the protection of cultivars. Thus, Uruguay possesses an effective *sui generis* system for the protection of plant varieties.

2. Please describe in detail any provisions in your law permitting the use of a patent without authorization of the right holder. Please cite the relevant provisions of law and describe in detail the conditions under which such use may occur.

Article 39 of the Patent Law stipulates that the rights conferred by patents shall not extend to the following: acts carried out in private for non-industrial or non-commercial purposes, provided that they do not cause economic prejudice to the owner of the patent (subparagraph (a)); the preparation of a medicine for a single patient, according to a medical prescription and under the supervision of an authorized professional (subparagraph (b)); acts carried out solely for experimental purposes, including acts anticipating future commercial exploitation carried out during the year prior to the expiry of the patent (subparagraph (d)); acts carried out for teaching, scientific or academic research purposes (subparagraph (e)); the importation of small quantities of goods of a non-commercial nature contained in the personal effects of travellers or sent in small packages (subparagraph (f)). Accordingly, third parties may avail themselves of these uses without the authorization of the patent owner.

According to Article 41 of the Patent Law, owners of patents may not prevent acts carried out, even without disclosure, by third parties who, in good faith, on the date of filing of the application or priority, where applicable, were already manufacturing the product or using the process that forms the subject-matter of the invention in Uruguay or had made serious preparations to manufacture, use or

work it. Such acts may be continued only to meet the needs of the exploiting enterprise and the right is not transferable without the exploiting enterprise.

In accordance with the Constitution and other special laws, Articles 42 and 43 of the Patent Law provide for inventions made in authorized monopolies belonging to the State or to private individuals to be patentable. However, they may be industrially or commercially worked only with the agreement of the holder of the monopoly or after the monopoly has expired. Like any property right, in accordance with the Constitution, patent rights may be expropriated by the State. This requires a special law and the owner must be granted appropriate compensation under a judicial procedure with every guarantee.

3. Does your legislation, in accordance with Article 27.1 in combination with Article 31 of the TRIPS Agreement, consider importation as "working" a patent (and therefore preclude compulsory licensing, if a product is being imported)?

The third paragraph of Article 54 of the Patent Law clearly establishes that the exploitation of a patent includes the importation of its subject-matter, in addition to its use and any other commercial activity relating thereto.

4. Does your legislation make the granting of a compulsory license subject to all the conditions enumerated in Article 31 of the TRIPS Agreement? Please cite the relevant provisions of law.

Articles 54 to 80 of the Patent Law (PL) authorize the granting of compulsory licences for various reasons: non-exploitation (Article 54), public interest (Articles 55 to 59), anti-competitive practices (Articles 60 to 63), unjustified refusal of a contractual licence (Articles 64 to 68), and dependent patents (Articles 69 and 70). The Law also contains a Chapter on general provisions and procedures (Articles 71 to 80) relating to compulsory licences. These articles lay down conditions for the granting of compulsory licences in accordance with Article 31 of the TRIPS Agreement.

Below, the corresponding provisions of the Patent Law are described in detail in the order of the paragraphs of Article 31 of the TRIPS Agreement:

- (a) The circumstances and requirements for the granting of licences for non-exploitation, reasons of public interest, anti-competitive practices, unjustified refusal of a contractual licence, and dependent patents are defined in Articles 54, 55, 60 and 61, 64, and 69 and 70, respectively.
- (b) Article 71 of the Patent Law lays down the requirements that persons wishing to obtain a compulsory licence must meet. Thus, they must have: requested a contractual licence from the owner of the patent and been unable to obtain it on fair commercial terms customary in Uruguay, within 90 days following the request. Under the second paragraph of Article 71, this requirement may be waived in situations of national emergency, extreme urgency, or in cases of non-commercial public use and anti-competitive practices.
- (c) From the provisions of Article 77 of the Patent Law, subparagraphs (a) and (c), as well as from the provisions cited in (a) above and those relating to the various types of compulsory licences (for example, Article 58 concerning public interest) it clearly follows that their scope and duration are limited to the purpose for which they were granted.

- (d) Article 73 (a) of the Patent Law clearly establishes that compulsory licences may not be exclusive.
- (e) According to Article 73(d) of the PL, a compulsory licence may not be assigned without that part of the enterprise or goodwill which exploits the subject-matter of the licence.
- (f) Article 56 of the PL establishes that in the case of compulsory licences for reasons of public interest, the supply will be exclusively to meet the needs of the domestic market.
- (g) Under Article 59 of the PL, uses granted under a compulsory licence may be withdrawn, subject to appropriate protection of the legitimate interests of the persons who have received the authorization, if the circumstances which gave rise to the authorization have ceased to exist and are unlikely to recur. The competent authorities are empowered to examine whether such circumstances still exist, on receiving a substantiated request.
- (h) Article 77(b) establishes that, in general, the licensor will be remunerated and that the amount of remuneration will be fixed according to the circumstances specific to each case, taking into account the economic value of the exploitation of the licensed invention, as well as other factors such as average royalties for the sector under commercial licensing agreements.
- (i) The resolutions granting compulsory licences are issued by the National Industrial Property Directorate (NIPD) or by the Executive Power, in the case of licences for reasons of public interest. Both resolutions may be reviewed, upon application for reconsideration or appeal to a higher administrative authority in the case of the NIPD, an agency subordinate to the Executive Power. After that, under the Constitution and special laws, any final State resolution may be set aside by the Administrative Tribunal, a specialized five-member quasi-judicial body.
- (j) According to Article 74 of the PL, if the parties are unable to agree on the appropriate remuneration or the other conditions for the granting of a compulsory licence, an arbitral tribunal shall be appointed to decide the matter. Its decision will be adopted by a resolution of the NIPD (Article 75) granting the licence. Consequently, as the fixing of the remuneration forms part of the NIPD decision granting the licence, it can be reviewed in the same way as the latter, i.e. by recourse to the appropriate administrative remedies and then by an action to set aside before the Administrative Tribunal, as described in the preceding paragraph.
- (k) The second paragraph of Article 71 states that in the case of compulsory licences for anti-competitive practices (Articles 60 to 63 of the PL), the interested party, the potential user, may disregard the requirements imposed by the first paragraph in other cases.
 - (i) According to Article 60 of the PL, a compulsory licence may be granted for anti-competitive practices if the competent authority, following administrative or judicial procedures that confer on the patent owner the right to a fair hearing and other guarantees, has previously determined that the owner has been involved in practices deemed anti-competitive or has abused the rights conferred by the patent or a dominant market position.

- (ii) Although the PL does not specifically provide for the correction of anti-competitive practices as a factor to be taken into account in fixing the amount of remuneration, inasmuch as the Law grants the competent authorities powers to determine that amount and to refuse to withdraw the authorization if the circumstances which gave rise to it are likely to recur, it is clear from the provisions as a whole that the authorities must take this factor into account. Thus, for example, Article 62 of the PL states that if the owner of the patent continues the acts or practices that led to the determination of anti-competitive practices or abuse of the rights conferred by the patent, the right to the patent may be cancelled, either *ex officio* or at the request of an interested party, subject to a prescribed period of notice.
- (l) As already mentioned, Articles 69 and 70 of the PL deal with the subject of “dependent patents”. According to Article 69, if a patented invention or utility model cannot be exploited without infringing an earlier patent, the owner or a licensee may request the grant of a compulsory licence in respect of the other patent, insofar as it is necessary to work the patent and avoid infringement. Article 70 lays down the conditions for the granting of this type of compulsory licence, namely: the invention claimed in the second patent must involve an important technical advance of considerable economic significance in relation to the invention claimed in the first patent (subparagraph (a)); the owner of the first patent must be entitled to obtain a cross licence on reasonable terms to use the invention claimed in the second patent (subparagraph (b)); and assignment of the authorized use of the first patent must include use of the second patent (subparagraph (c)).

The other requirements of Article 31 of the TRIPS Agreement concerning notification of the patent holder as soon as reasonably practical when compulsory licences are granted in situations of national emergency (subparagraph (b)); the informing of the right holder in cases of public non-commercial use; the restriction of compulsory licences for semi-conductor technology to cases of public non-commercial use or the remedying of anti-competitive practices (subparagraph (c)); and, in part, use predominantly for the supply of the domestic market are not specifically provided for in the PL. However, they are mandatory by application of the general principles laid down in the legislation, such as those requiring that the patent holder be notified or informed, or because the provisions of the TRIPS Agreement itself so require, since, as has repeatedly been pointed out, these provisions have been incorporated into the national legislation and form part of domestic law, for example Law No. 16.671 of 13 December 1994 on semi-conductor technology.

5. Please indicate the term of protection granted to patents according to your law? Does your law allow use of a patented invention for the purposes of marketing authorization procedure for a copy product before expiry of the term of patent protection? If yes, please indicate the exact scope and nature of such use. Please cite the relevant provisions of your law.

Under Article 21 of the PL, the term of protection for patents for inventions is 20 years from the date of filing of the application.

This use falls within the scope of Article 30 of the TRIPS Agreement which authorizes Members to provide limited exceptions to patent rights.

There is no express provision for this in the PL.

Among the exceptions to the rights conferred by a patent, Article 39(c) of the PL mentions only acts carried out solely for experimental purposes, including acts anticipating future commercial exploitation, carried out during the year preceding the expiry of the patent.

6. Does your legislation provide for the principle of the reversal of burden of proof in a process patent litigation? Please cite the relevant provisions of law.

In accordance with Article 34 of the TRIPS Agreement, Article 101 of the PL establishes that in civil proceedings if the subject-matter of the patent is a process for obtaining a product, the judicial authorities have the authority to order the defendant to prove that the process to obtain the product is different from the patented process, provided that the product is new.

B. PROTECTION OF UNDISCLOSED INFORMATION

7. Please explain in detail if your legislation ensures that undisclosed test or other data submitted by an applicant to the responsible State agency in the procedure for market authorization of a pharmaceutical or of an agricultural chemical product is protected against disclosure and against unfair commercial use by a competitor, for example by prohibiting a second applicant from relying on, or from referring to the original data of the first applicant, when applying subsequently for market authorization for a similar product. Does your legislation provide for exceptions to this? If yes, under what conditions would such exceptions apply? Does your legislation set a specific term of protection for undisclosed test or other data of the first applicant?

Undisclosed information is protected in accordance with Article 39.1 of the TRIPS Agreement under the heading of unfair competition (Article 10*bis* of the Paris Convention). With regard to undisclosed test or other data submitted to the competent authority as a condition of approval of the marketing of pharmaceutical or agricultural chemical products, provided they meet the requirements of Article 39.3 of the TRIPS Agreement, they will be protected against unfair commercial use. Moreover, Article 197 of Law No. 17.296 stipulates that officials of the Ministry of Livestock, Agriculture and Fisheries who obtain information in the course of their inspection activities must keep that information secret and preserve the confidentiality of any administrative or judicial proceedings of which they have knowledge.

At the same time, Article 6 of Executive Decree No. 324/999 of 12 October 1999 on the approval of the marketing of pharmaceutical products stipulates that the applicant must declare the undisclosed nature of information provided for the purpose of obtaining authorization.

Follow-up question:

With regard to the unfair commercial use of data submitted by an applicant to the relevant state agency as part of the procedure to obtain market authorization for a pharmaceutical or agricultural chemical product, please specify whether the relevant state agency will require the same amount of data from a second applicant requesting market authorization for a similar or identical product, as it required from the first applicant.

If the answer is affirmative, does your legislation provide for a time period, after which the second applicant can refer to the data of the first applicant and therefore not have to submit this data in his own application for market authorization?

As regards the protection of undisclosed information, Uruguay does not have any specific legislative provisions.

The provisions of the TRIPS Agreement and the Paris Convention – in particular those of Article 10*bis* on unfair competition – have been incorporated into Uruguay's domestic law. Consequently, and via the application of these provisions and the general rules and principles of law,

any act performed with regard to undisclosed test or other data which implies unfair competition is unlawful and will give rise to civil and criminal proceedings.

Consequently, the protection of such data against all unfair competition laid down in Article 9.2 and 39.3 of the TRIPS Agreement is adequately provided for in Uruguay's legislation.

Section A.6 of the regulations on marketing approval for pharmaceutical products, Executive Decree No. 324/1999 of 12 October 1999, stipulates that the applicant must declare the undisclosed nature of information in the data which is submitted in order to obtain authorization.

Uruguay has no provisions which stipulate that the authority responsible for giving sanitary approval cannot use the test data which it has previously had access to when issuing authorization, for the same product of another owner, apart from the aforementioned protection against unfair use under Article 39.3 of the TRIPS Agreement.

C. ENFORCEMENT

8. Please indicate remedies provided by your legislation which constitute effective deterrents to infringements of intellectual property rights.

Articles 99 to 102 of the Patent Law contain specific provisions which supplement the general provisions of civil and procedural law to create a legislative framework that provides a level of protection consistent with the requirements of Part III of the TRIPS Agreement.

According to Article 99, the patent owner, or owners where there are several, may bring civil proceedings against anyone who infringes his rights.

Article 99 also states that the patent owner may seek compensation for infringing acts carried out between the publication of the application and the grant of the patent, as well as for acts carried out before publication if the infringer was aware of the content of the patent before publication.

Article 100 makes those who market or distribute infringing products liable for the injury and prejudice caused, if there is definite evidence of their knowing that the products infringed patent rights.

Article 101 establishes the above-mentioned reversal of the burden of proof in cases of process patent infringement.

Article 102 authorizes a licensee to take action to defend the rights deriving from the patent.

Article 103 empowers the judicial authorities to adopt, *ex officio* or at the request of a party, any of the extensive provisional or precautionary measures for which the General Code of Procedure provides.

Article 104 fixes the time-limit for bringing a civil action for damages at 4 years from the date on which the patent owner became aware of the infringement.

Article 105 allows the true inventor to institute claim proceedings where a patent application has been filed by someone who is not the inventor, and to request that the patent be assigned to him. These proceedings are subject to a time-limit of 5 years from the date of grant of the patent or 2 years from the date on which it began to be worked.

Articles 87 and 88 of Trademark Law No. 17.011 allow actions for damages to be brought and prohibit the use of infringing trademarks, while specifying the judicial procedures for ensuring compliance.

9. Please describe any new initiatives that are planned to improve enforcement of intellectual property rights in your country, particularly initiatives related to criminal enforcement.

Copyright and related rights

In the field of copyright, Uruguay has a series of measures for dealing with civil and criminal infringements.

Where civil proceedings are concerned, Article 51 of the copyright law in force (Law No. 9.739 of 17 December 1937) stipulates, for both national and foreign works, that “The injured party, the author or his successor in title may bring a civil action for damages and for the surrender of all profits and income improperly received by the infringer. In all cases it shall be possible to bring a subrogatory action, in accordance with Article 1.295 of the Civil Code...”.

Article 47 of Copyright Law No. 9.739 of 17 December 1937, as amended by Article 328 of Law No. 16.170 of 27 December 1990, stipulates that: “The unlawfully reproduced copies and any materials used for reproduction, communication or public performance shall be seized. As a preparatory measure, the interested party may request their attachment and, where good cause can be shown, apply to the competent court for exemption from counter-security. The judgement shall, in all cases, order the destruction or disablement of the copies and materials seized, if these are able to be used, to the extent necessary to prevent unlawful exploitation. Copies acquired by third parties in good faith for their personal use shall not be destroyed.”

Where criminal enforcement is concerned, Article 46 of Law No. 9.739 of 17 December 1937, as amended by Article 23 of Law No. 15.913 (Book Law) of 17 November 1987, stipulates that:

“Whoever publishes, sells, reproduces or causes to be reproduced by any means, in whole or in part, an unpublished or published work without the written authorization of its author or his successor in title or its purchaser, in whatever capacity, or attributes it to a different author, thereby contravening the provisions of this Law, shall be liable to a term of from three months' to three years' imprisonment.”

Law No. 15.289 of 14 July 1982 created a category of criminal offence that protects producers of phonograms and/or videograms from unauthorized reproductions. According to Article 1, “Anyone reproducing a phonogram or videogram for gain and without the written authorization of its producer, and anyone distributing to the public or stocking for that purpose the reproductions thus obtained, shall be liable to the penalty laid down in Article 46 of Law No. 9.739 of 17 December 1937. The same penalty shall be applicable to anyone fixing the live performance of a literary or artistic work by any means, clearly for the purpose indicated in the previous sentence and without the written authorization of the author and the performer, as well as to anyone distributing to the public or stocking for that purpose the versions thus obtained.”

In relation to criminal enforcement, a draft Law establishing a new regulatory framework for copyright has been approved by the Chamber of Representatives and is currently being considered in the Chamber of Senators.

A basically new measure that would be introduced under the criminal law would be that for which Article 146 of the draft Law provides, namely: "Whoever, without the authorization of their author or respective owner protected by this Law, introduces works, performances, phonograms or broadcasts into a data storage system for the purpose of reproducing or distributing them shall be liable to imprisonment for three to 24 months."

Industrial property

As has just been shown, the new Laws on trademarks and other distinctive signs (No. 17.011 of 25 September 1998) and on patents, utility models and industrial designs (No. 17.164 of 2 September 1999) contain many important provisions concerning the enforcement of the corresponding intellectual property rights which supplement and support the general measures derived from ordinary civil and procedural law.

The criminal provisions relating to patents in Articles 106 and 107 of the Patent Law are as follows:

Article 106 provides for a term of six months' to three years' imprisonment for anyone who infringes any of the rights protected by patents. It also provides for the forfeiture of the infringing products and the implements used in making them.

Article 107 increases the term of imprisonment to 15 months to four years in the following aggravating circumstances: (a) where the infringer was an employee of the patent owner or a licensee and (b) where he obtained from the latter knowledge of the special methods of making the patented product.
